

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

No. 11,320
JOINT APPENDIX

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

668

United States Court of Appeals

For the

District of Columbia Circuit

FILED

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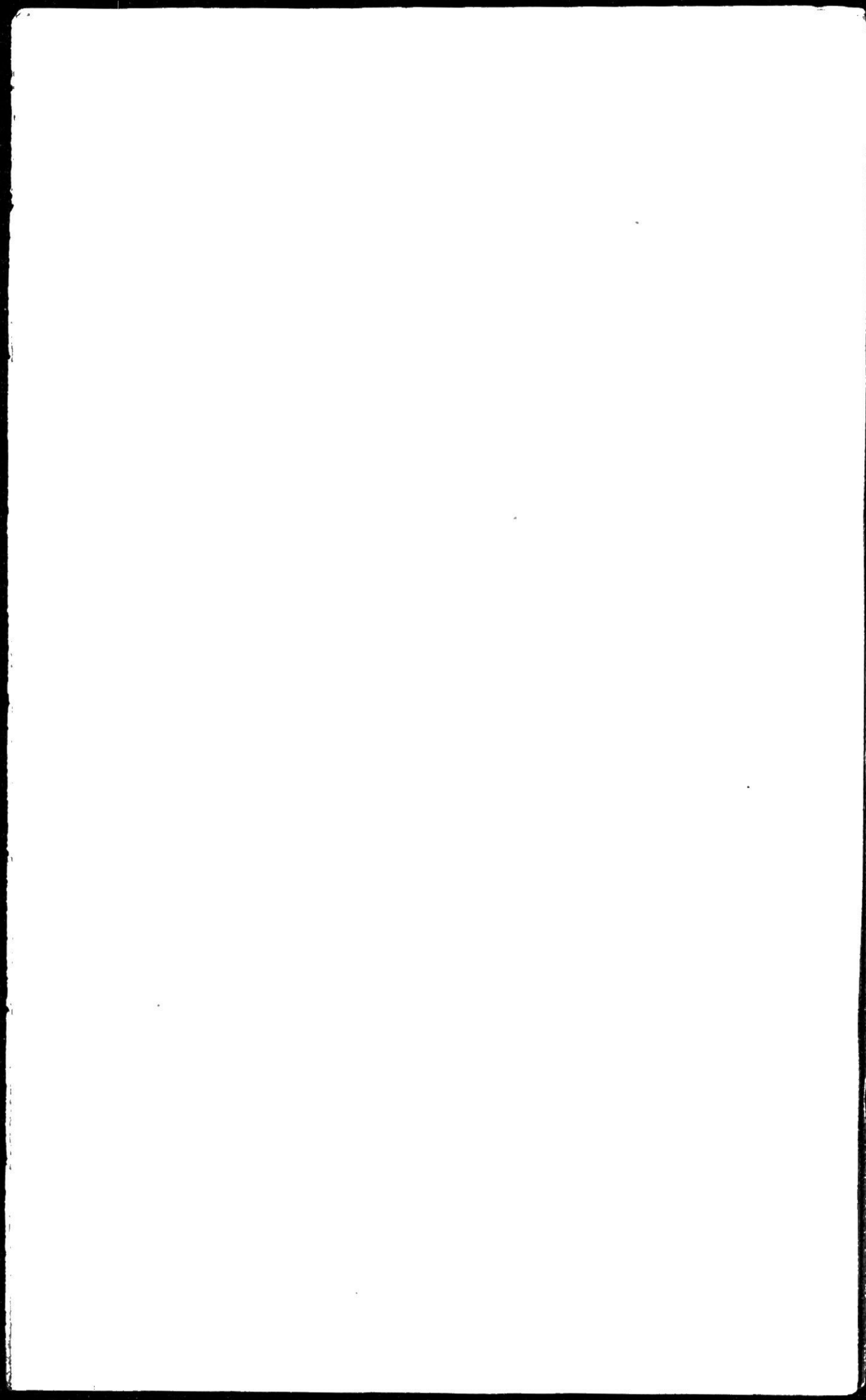
Joseph W. Stewart
CLERK

OD WIKAR CHRISTENSSON, *Appellant*,

v.

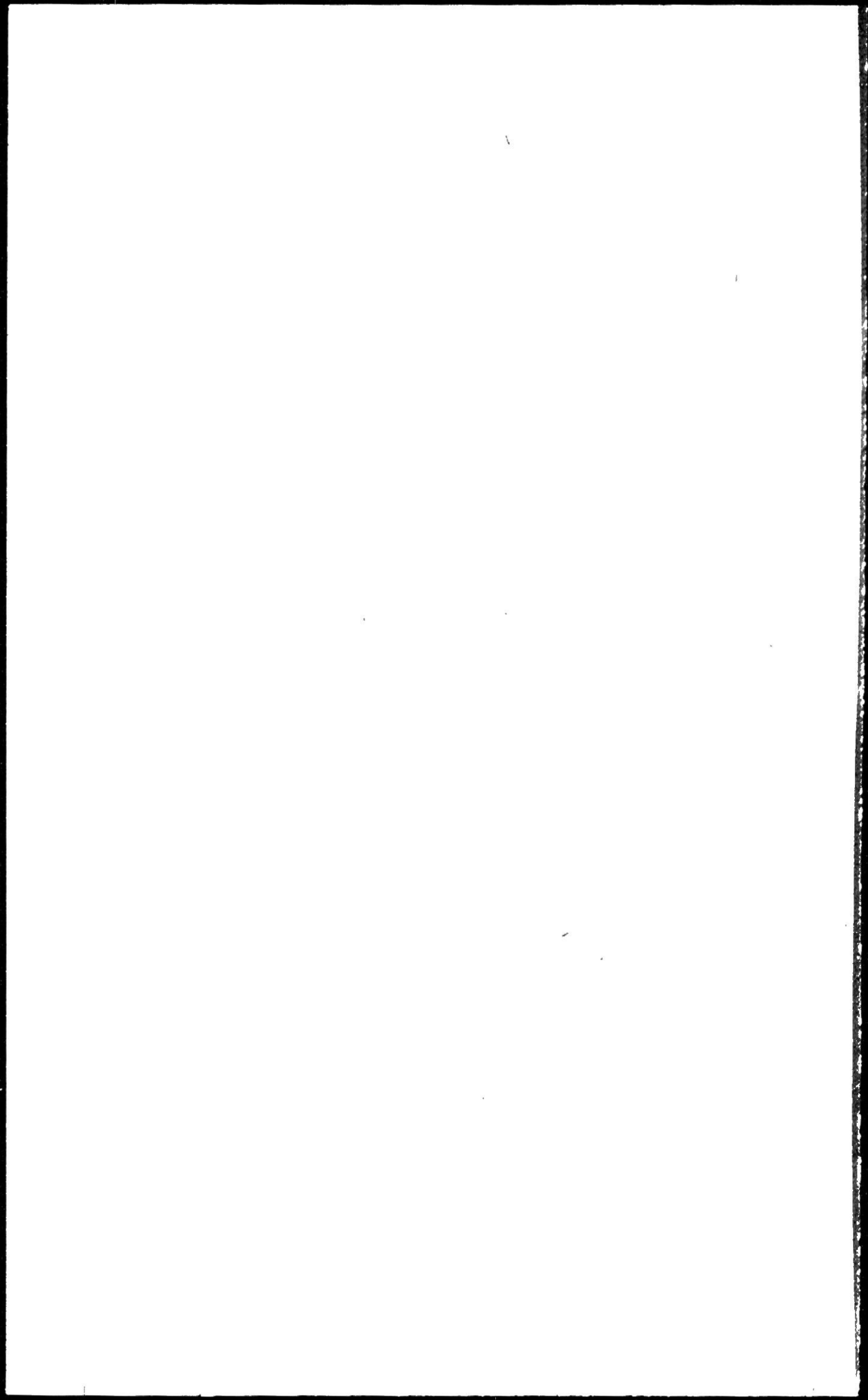
STIG BEERTIL HOGDAL and JOHN A. MARZALL,
Commissioner of Patents, *Appellees*.

Appeal from the United States District Court
for the District of Columbia



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United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 11,320

OD WIKAR CHRISTENSSON, *Appellant*,

v.

STIG BERTIL HOGDAL and JOHN A. MARZALL,
Commissioner of Patents, *Appellees*.

Appeal from the United States District Court
for the District of Columbia

JOINT APPENDIX

8 Filed May 28 1951 Harry M. Hull, Clerk
UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Od Wikar Christensson
Narvaridgen 34
Stockholm, Sweden

Plaintiff

vs.

Stig Bertil Hogdal
Danderyd, near Stockholm, Sweden

Defendant

vs.

John A. Marzall
Commissioner of Patents
United States Patent Office
Washington, D. C.

Defendant

Civil Action No. 2217—'51

Civil Action for Issuance of Patent Under R. S. 4915

The plaintiff, for a first cause of action, states as follows:

I

This action arises under Section 4915 of the Revised Statutes of the United States (U. S. Code, Title 35, Sections 63 and 72a) as amended by Acts of March 2, 1927, March 2, 1929, and August 5, 1939. This Court has jurisdiction of this cause by virtue of such Revised Statute.

II

Plaintiff, Od Wikar Christensson, is subject of the King of Sweden, and is a resident of Stockholm, Sweden.

III

Defendant, Stig Bertil Hogdal, is a subject of the King of Sweden, and a resident of Danderyd, near Stockholm, Sweden, and is the patentee named in United States Letters Patent No. 2,427,858, which issued on an application filed August 16, 1943, Serial No. 498,820.

IV

Defendant, John A. Marzall, is the Commissioner of Patents of the United States, a legal resident of the District of Columbia and is sued as Commissioner of Patents of the United States.

V

On September 19, 1947 there was filed in the United States Patent Office an application in the name of the plaintiff, Od Wikar Christensson, which application was entitled "Packages" and was accorded Serial No. 774,987.

VI

Plaintiff, Od Wikar Christensson, is, within the meaning of the Statutes of the United States, the first, original, and sole inventor or discoverer of certain new and useful improvements in "Packages" as disclosed in said application, Serial No. 774,987, referred to in the preceding paragraph, that said improvements were not known or used by others before his invention thereof, and were not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than one year prior to his said application for United States Letters Patent therefor, and not in public use or sale in this country for more

than one year prior to his said application and not
10 first patented in any foreign country by him or his
legal representatives or assigns on an application
filed more than twelve months prior to the filing of his

said application for United States patent, as such twelve month period has been extended by the Boykin Law, Public Law 690, and that the same has not been abandoned.

VII

During the prosecution of plaintiff's patent application, Serial No. 774,987, said application was amended to add thereto Claims 4 and 5 which were copied from the said Hogdal patent No. 2,427,858, in which they appear as Claims 1 and 2. When such claims were copied into said application, the plaintiff, Od Wikar Christensson requested that the Patent Office declare an Interference between his said application and said patent of Hogdal, No. 2,427,858. Such request for the declaration of an Interference was predicated on the fact that said patent, and said application, disclosed and claimed the same invention, and that the application of plaintiff, Od Wikar Christensson, Serial No. 774,987, was, by virtue of the provisions of Sections 4886 and 4887 of the Revised Statutes (U.S.C. Title 35, Sections 31 and 32) and Public Law 690, entitled to an effective filing date in this country earlier than any date to which the defendant, Hogdal, was entitled.

VIII

On February 8, 1949 the United States Patent Office, as so requested, did declare an Interference No. 85,709 between the plaintiff, Od Wikar Christensson, and the defendant, the patentee, Stig Bertil Hogdal, involving said application of the plaintiff, Serial No. 774,987, and the patent of Hogdal, No. 2,427,858.

When said Interference No. 83,709 was declared, the counts or issues of said Interference were two in number and corresponded to Claims 1 and 2 of the defendant.

Hogdel's patent No. 2,427,858, which are identical to Claims 4 and 5 of the application of the plaintiff, Od Wikar Christensson, Serial No. 774,987.

X

The said counts of said Interference No. 83,709, as declared, are allowable, are readable upon the applications of the plaintiff, Od Wikar Christensson, and the patent of the defendant, Hogdal, and read as follows:

1. A package for the purpose set forth, comprising a box of stiff material and an unslitted lining inserted therein, said box having side panels and, at least at one end, a set of top panels foldably connected with the respective side panels of the box for closing the package, one of said top panels being a separate closing flap, while the remaining top panels are joined with adjacent top panels at the corners of the box, two of said top panels having fold lines extending diagonally from their free top corners to their bottom corner which is connected with an adjacent top panel the lining being longer than the box so as to project beyond the upper edges of the top panels, so that upon folding down the said coherent top panels to close the respective end of the package the projecting mouth portion of the lining extends in the folded down state of said coherent end panels up between the base of the separate flap and the upper edge of the opposite one of the coherent end panels and may be folded around said upper edge and jammed between the separate flap and said opposite end panel by folding the separate flap down against said opposite end panel and be sealed in said position by pasting, the lining being pasted to the box adjacent the base of the separate flap to retain the lining in position especially during the folding operations.

2. A package as claimed in claim 1, in which the separate flap comprises a whole end panel of the box.

Within the time duly set by the United States Patent Office, plaintiff, Od Wikar Christensson filed a Preliminary Statement in said Interference No. 83,709, alleging that on November 13, 1940 there was filed in the Royal Patent and Registering Office, Stockholm, Sweden, a Swedish patent application No. 4496/1940, directed to the same invention of the counts of said Interference, and that said Swedish application was filed on his behalf by Aktiebolaget Centrala Kartongfabriken, of Ulvsunda, Sweden, and that such was in accordance with the practice in Sweden; that said Swedish application is the original and the first application directed to the invention of the counts of the Interference filed by, or on behalf of the plaintiff, Od Wikar Christensson, in any country.

The defendant, Hogdal, did not file a Preliminary Statement in said Interference No. 83,709, but in a communication filed in the United States Patent Office on April 4, 1949, elected to rely upon the filing dates of certain Swedish applications.

XII

In said Interference No. 83,709, the Patent Office set the motion period to expire June 25, 1949. Within the motion period the plaintiff, Od Wikar Christensson, filed a Motion to Shift Burden of Proof and for Judgment on the Record. Also, within the motion period the plaintiff, Od Wikar Christensson, filed a certified typewritten copy of Swedish patent application No. 4496/1940, a translation thereof, and an affidavit of one, Stig Hammar. Said Motion to Shift Burden of Proof by plaintiff, Od Wikar

Christensson, alleged that plaintiff, Christensson,
13 was entitled to an effective filing date of November 13, 1940, which is the date of the first filed Christensson foreign application, namely, said Swedish application No. 4496/1940. During the prosecution of the

Christensson application Serial No. 774,987 the plaintiff, Christensson, had filed a request under Public Law 690, based on said Swedish application No. 4496/1940. The Patent Office had then ruled that Christensson, having complied with the provisions of Section 1, Public Law 690, was considered as entitled to a priority date of November 13, 1940. Christensson, in the Interference, urged that such effective filing date is earlier than any date to which the defendant, Hogdal, is entitled for his patent No. 2,427,858.

XIII

The application of the defendant, Hogdal, which matured as patent No. 2,427,858, which became involved in said Interference No. 83,709, mentioned two foreign applications in the oath. These were Swedish application, filed July 29, 1940, and Swedish application, filed July 17, 1942. The first matured as Swedish patent No. 121,065 in 1948. The second became Swedish patent 107,192 in 1943 and during the prosecution of said Hogdal United States application was the basis for rejection as a statutory bar. The defendant, Hogdal, made a request for the benefits of Public Law 690, basing such request solely on the Hogdal Swedish application, filed July 17, 1942. That request for the benefits of Public Law 690 was granted. No request was made by defendant, Hogdal, for the benefit of the filing date of the Swedish application, filed July 29, 1940, and no certified copy of that application was ever filed by the defendant, Hogdal, in the United States Patent Office, during the prosecution of the application which matured as patent No. 2,427,858.

14 Hogdal filed another Swedish application prior to that filed on July 29, 1940. The records of the Swedish Patent Office reveal that an application was filed on May 20, 1940 and accorded No. 1834/1940. No mention of such Swedish application was made in the Hogdal

United States application which became patent No. 2,427,858. No request for the Public Law 690 was based thereon, even though said application is the first filed foreign application of the defendant, Hogdal.

XIV

On October 5, 1949 the Examiner in the Patent Office rendered a decision on said Motion and ruled that the plaintiff, Christensson, had a disclosure of the invention in said Swedish application No. 4496/1940, not on the date of filing said application on November 13, 1940, but later on April 2, 1941, and that said latter disclosure on April 2, 1941 entitled the plaintiff, Christensson, to such date as the effective filing date for his United States application. Accordingly, the Motion to Shift the Burden of Proof was granted. On November 3, 1949 the Patent Interference Examiner issued an Order on Hogdal to Show Cause why judgment on the record should not be entered against him.

XV

Following said Order to Show Cause, numerous memoranda, and other documents were filed by the parties to Interference No. 83,709, as follows:

"Motion to vacate the order to show cause, filed by Hogdal November 18, 1949.

"Motion to set the interference down for final hearing under Rule 130, filed by Hogdal November 18, 1949.

15 "Certified copy of documents filed in the Swedish Patent Office on April 2, 1941 relating to application 4496/1940 and a translation thereof, filed by Christensson December 22, 1949.

"Motion to strike, filed by Christensson December 27, 1949.

"Memorandum in opposition to Hogdal's motion to vacate the order to show cause, filed by Christensson December 30, 1949.

"Motion to strike Christensson's certified copy and translation, filed by Hogdal January 5, 1950.

"Motion to dismiss the interference, filed by Hogdal January 5, 1950.

"Memorandum in opposition to Hogdal's motion to dismiss the interference, filed by Christensson January 17, 1950.

"Memorandum in opposition to Hogdal's motion to strike Christensson's papers, filed by Christensson January 17, 1950.

"Substitute motion to set the interference down for final hearing under Rule 256, filed by Hogdal May 3, 1950."

XVI

There was a Final Hearing on October 10, 1950 and on November 28, 1950 the Board of Interference Examiners of the United States Patent Office rendered a decision in said Interference No. 83,709, holding that the plaintiff, Christensson, was entitled for his said United States application, Serial No. 774,987, to an effective filing date as of April 2, 1941, the date upon which a complete disclosure was filed in its first filed Swedish application No. 4496/1940. The Board of Interference Examiners, then for the first time, held that priority of the subject matter in issue should be awarded to the defendant, Stig Bertil Hogdal, on the ground that the Swedish application the plaintiff, Christensson, did not disclose one element of the counts of said Interference.

The Swedish application of the plaintiff, Christensson, No. 4496/1940, and his application, Serial No. 774,987, involved in said Interference No. 83,709, clearly and fully discloses all elements recited in said counts of said Interference, and the Board of Interference Examiners in said decision dated November 28, 1950, in ruling to the contrary, erred as a matter of fact, and erred also as a matter of law in awarding priority of the invention which is the subject matter of the counts to the defendant, Stig Bertil Hogdal.

As a second cause of action the plaintiff states, as follows:

XVIII

Patent No. 2,427,858, granted to the defendant, Hogdal, is invalid in that the patentee, Hogdal, did not in filing and prosecuting the application from which it matured comply with the provisions of Sections 4886 and 4887 of the Revised Statutes (U.S.C. Title 35, Sections 31 and 32) and of Public Law 690. Section 4887 of the Revised Statutes and Public Law 690 provide that the benefits thereof shall not be accorded an applicant unless the oath of the application shall refer to the earliest date upon which a foreign application disclosing the invention is filed, Public Law 690 further providing that a requisite to obtaining the benefits of such law is that a certified copy of such original foreign application be filed in the United States Patent Office by the applicant within a prescribed period. The original foreign application of defendant, Hogdal, was the Swedish application of May 20, 1940, No. 1834/1940 and this was not recited in the oath of the Hogdal
17 United States application, Serial No. 498,820, nor was a certified copy thereof ever submitted by Hogdal to the United States Patent Office in compliance with Public Law 690.

XIX

The defendant Hogdal's Swedish patent No. 107,102, granted in 1943, discloses the invention of defendant's United States patent No. 2,427,858 and comprises a statutory bar to the granting of said patent. The defendant, the Commissioner of Patents, was aware of said Hogdal's Swedish patent No. 107,192 during the prosecution of the United States application of Hogdal, Serial No. 498,820, which later matured as patent No. 2,427,858, and failed to finally reject said application as barred by Swedish patent.

XX

The defendant, the Commissioner of Patents, during prosecution of the United States Hogdal patent application, Serial No. 498,820, by virtue of the recitation in the oath in said application, was apprised of the fact that the Hogdal Swedish application, filed July 17, 1942, (which became Swedish patent No. 107,192) was not the first and original foreign application of Hogdal directed to the invention of said United States application of Hogdal, Serial No. 498,820, and thus improperly and erroneously accorded to Hogdal the benefits of Public Law 690 on the basis of such Swedish application, filed July 17, 1942, contrary to the explicit requirements of said Public Law 690.

XXI

The erroneous action of the defendant, the Commissioner of Patents, in disregarding the explicit requirements of United States Statutes and in granting patent No. 2,427,858 to the defendant, Hogdal, has resulted in the grant of an invalid patent which should be declared as having no force and effect. Such action has caused considerable damage and expense to plaintiff, 18 Christensson, and has and is misleading the public generally and causing damage and expense to many members of the public.

WHEREFORE, plaintiff prays for the judgment of this Court that:

1. Plaintiff, Od Wikar Christensson, was and is the first inventor of the subject matter in issue in said Interference No. 83,709, and is entitled to an award of priority therefore and to the issuance of a patent containing the counts of said Interference.

2. The defendant, Commissioner of Patents, be authorized and directed to award priority of invention of the subject matter of said Interference No. 83,709 to the plaintiff, Od Wikar Christensson, and to issue to the plaintiff a patent containing claims directed to such subject matter.

3. The defendant, the Commissioner of Patents, be authorized and directed to cancel from the records of the Patent Office the patent of the defendant, Hogdal, No. 2,427,858, as invalid and void and as knowingly granted by the defendant, the Commissioner of Patents, contrary to the statutes of the United States, and in particular, Revised Statutes 4886, 4887, and Public Law 690.

4. This Court declare said patent, No. 2,427,858, as invalid and void and as being obtained contrary to and in disregard of specific provisions of Statutes of the United States.

5. For such other and further relief of the premises as the merits of the case may require.

OD WIKAR CHRISTENSSON
By Roberts B. Larson
Roberts B. Larson
Solicitor for Plaintiff
800 National Press Building
Washington, D. C.

19 Summons in a Civil Action

D. C. Form No. 45 Rev. (6-49)

UNITED STATES DISTRICT COURT

for the
District of Columbia

.....Division

Civil Action File No. 2217-51

Od Wikar Christensson

Plaintiff

v.

Stig Bertil Hogdal

JOHN A. MARZALL, Commissioner of Patents
U. S. Patent Office

Defendant

SUMMONS

To the above named Defendant: JOHN A. MARZALL, Commissioner of Patents. You are hereby summoned and required to serve upon Roberts B. Larson plaintiff's attorney, whose address is 800 National Press Bldg., Wash. D. C. an answer to the complaint which is herewith served upon you, within 60 days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint.

Harry M. Hull, Clerk of Court. Anne W. Lyddane,
Deputy Clerk. [Seal of Court]

Date: May 28, 1951

20 Filed Jun 27 1951 Harry M. Hull, Clerk

RETURN ON SERVICE OF WRIT

I hereby certify and return, that on the 28th day of May 1951, I received this summons and served it together with the complaint herein as follows:

delivering a copy of said summons and complaint to the within named. U. S. Attorney G. M. Fay, defendants 5/29/51 by serving Mrs. Longer, Secretary John A. Marzall, Commissioner of Patents, U. S. Patent office personally 5/31/51 by serving E. L. Reynolds, Solicitor Attorney General J. H. McGrath personally 6/7/51 by serving registered mail number 871625.

Travel \$....., Service \$1.

W. Bruce Matthews, United States Marshal.

By M. Calasanto, E. J. McClay, M. Ferris, Deputy
United States Marshal.

Subscribed and sworn to before me, a this
day of 19 .

[Seal]

Note.—Affidavit required only if service is made by a person other than a United States Marshal or his deputy.

21 Summons in a Civil Action

D. C. Form No. 45 Rev. (6-49)

UNITED STATES DISTRICT COURT

for the

District of Columbia

Civil Action File No. 2217-51

Od Wikar Christensson

Plaintiff

V.

Stig Bertil Hogdal

John A. Marzall, Commissioner of Patents
Defendant

SUMMONS

To the above named Defendant: Stig Bertil Hogdal. You are hereby summoned and required to serve upon Roberts B. Larson plaintiff's attorney, whose address is 800 National Press Bldg., Wash. D. C., an answer to the complaint which is herewith served upon you, within 20 days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint.

Harry M. Hull, Clerk of Court. Anne W. Lyddane, Deputy Clerk. [Seal of Court]

Date: May 28, 1951

22 Filed June 27 1951 Harry M. Hull, Clerk

RETURN ON SERVICE OF WRIT

I hereby certify and return, that on the 28th day of May 1951, I received this summons and complaint and the within named defendant Stig Bertil Hogdal is NOT TO BE FOUND in this district. 6/19/51.

Marshal's Fees Travel \$..... Service \$1.

W. Bruce Matthews, United States Marshal. By Mary Heeb, Deputy United States Marshal.

Subscribed and sworn to before me, a
this day of 19 .

[SEAL]

* * * *

23 Filed Jul 3 1951 Harry M. Hull, Clerk

Motion To Dismiss

Now comes the defendant John A. Marzall, Commissioner of Patents and moves to dismiss the complaint in

the above-entitled action for lack of jurisdiction due to the absence of a necessary party.

The said defendant also moves to dismiss the complaint as to paragraphs XVIII to XXI inclusive on the further grounds that the Court lacks jurisdiction of the subject matter of those paragraphs under R. S. 4915 (U. S. C. title 35, sec. 63), and that, in any case the Commissioner of Patents is not a proper party to an action seeking to adjudicate the validity of a patent.

An oral hearing is requested.

Respectfully submitted,

/s/ E. L. Reynolds, Solicitor, U. S. Patent Office, Attorney for Defendant, John A. Marzall, Commissioner of Patents.

* * * *

33 Filed Jul 12 1951 Harry M. Hull, Clerk

Affidavit

I, Roberts B. Larson, being duly sworn, do depose and say that I am the attorney for the plaintiff in the above Civil Action. That to the best of my knowledge and belief the defendant, Stig Bertil Hogdal, is a resident of Danderyd near Stockholm, Sweden, and has never been a resident within the District of Columbia.

/s/ Roberts B. Larson

Sworn to and subscribed before me this 6th day of July, 1951.

/s/ H. S. Imirie,
Notary Public, D. C.

My Commission expires Nov. 30, 1954.

* * * *

34 Filed Jul 13 1951 Harry M. Hull, Clerk

The object of this suit is the obtaining of a patent based on plaintiff's United States Patent application, Serial No. 774,987, filed September 19, 1947. Said application and the U. S. Patent 2,427,858 to defendant, Stig Bertil Hogdal were involved in Interference No. 85,709 instituted by the United States Patent Office on February 8, 1949.

This suit also requests a ruling that Patent No. 2,427,858 is invalid.

On motion of the plaintiff, it is this 13th day of July, 1951, ordered that the defendant, Stig Bertil Hogdal, Danderyd, near Stockholm, Sweden, cause his appearance to be entered herein on or before the fortieth day, exclusive of Sundays and legal holidays, occurring after the day of the first publication of this order; otherwise the cause will be proceeded with as in case of default. Provided, a copy of this order be published once a week for three successive weeks in the Washington Law Reporter, and the Washington Post before said day.

/s/ Matthew G. McGuire,
Judge.

Attest: Harry M. Hull, Clerk.

* * * *

35 Summons in a Civil Action

D. C. Form No. 45 Rev. (6-49)

UNITED STATES DISTRICT COURT
for the
District of Columbia

..... Division

Civil Action File No. 2217-51

Od Wikar Christensson

Plaintiff

v.

Stig Bertil Hogdal

JOHN A. MARZALL, Commissioner of Patents,
U. S. Patent Office

Defendant

Accepted Service on Behalf of the Within Named Defendant Stig Bertil Hogdal this 2 day of Aug. 1951
William M. Cushman, Attorney for Defendant.

SUMMONS

To the above named Defendant: Stig Bertil Hogdal. You are hereby summoned and required to serve upon Roberts B. Larson, plaintiff's attorney, whose address National Press Building, an answer to the complaint which is herewith served upon you, within 20 days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint.

Harry M. Hull, Clerk of Court. Daniel J. Mencobom, Deputy Clerk. [Seal of Court]

Date: August 1, 1951.

36 Filed Aug 6 1951 Harry M. Hull, Clerk

Return on Service of Writ

I hereby certify and return, that on the 1st day of Aug. 1951, I received this summons and served it together with the complaint herein as follows:

by delivering a copy of said summons and complaint to the within name ddefendants. Stig Bertil Hogdal personally 8/2/51 by serving his attorney, William M. Cushman.

Subscribed and sworn to before me, a this
day of 19 .

38 Filed Sep 18 1951 Harry M. Hull, Clerk

in

District of Columbia, ss.

Witness my hand and official seal this 9th day of August 1951.

/s/ DeVee K. Fisher,
Notary Public, D. C.

Roberts B. Larson
Attorney for Plaintiff
800 National Press Bldg.
Washington, D. C.

UNITED STATES DISTRICT COURT for the District
of Columbia. Od Wikar Christensson, plaintiff, versus

Stig Hertil Hogdal and John A. Marzall, Commissioner of Patents, defendants. Civil Action No. 2217-51. Filed July 13, 1951. Harry M. Hull, Clerk. The object of this suit is the obtaining of a patent based on plaintiff's United States patent application, Serial No. 774,987, filed September 19, 1947. Said application and the U. S. Patent 2,427,858 to defendant. Stig Bertil Hogdal, were involved in Interference No. 85,709 instituted by the United States Patent Office on February 8, 1949. This suit also requests a ruling that Patent No. 2,427,858 is invalid. On motion of the plaintiff, it is this THIRTEENTH DAY OF JULY, 1951, ordered that the defendant, Stig Bertil Hogdal, Danderyd, near Stockholm, Sweden, cause his appearance to be entered herein on or before the fortieth day, exclusive of Sundays and legal holidays, occurring after the day of the first publication of this order; otherwise the cause will be proceeded with as in case of default. Provided, a copy of this order be published once a week for three successive weeks in the Washington Law Reporter and The Washington Post before said day. (Signed) MATTHEW F. McGUIRE, Judge. Attest, HARRY M. HULL, Clerk. By Ella McDonald, Deputy Clerk.

July 19, 26, August 2.

I Hereby Certify that the foregoing advertisement was printed and published in The Washington Post, a daily newspaper, upon the following dates, at a cost of Thirty-two & 25/100.....Dollars: July 19, 26, August 2, 1951.

/s/ F. W. Sullivan

39 Filed Sep 18 1951 Harry M. Hull, Clerk
IN THE UNITED STATES DISTRICT COURT FOR
THE DISTRICT OF COLUMBIA

This 6th day of August, 1951

Od Wikar Christensson, Plaintiff v. Stig Bertil Hogdal
and John A. Marzall, Commissioner of Patents

Civil Action No. 2217-51

AFFIDAVIT

District of Columbia, to wit:

Personally appeared before me, a Notary Public in and for the said District, EDWIN H. EVANS, who being duly sworn according to law, on oath says he is the Manager of "THE LAW REPORTER PRINTING COMPANY," publishers of "THE WASHINGTON LAW REPORTER," a weekly newspaper printed and published in the District aforesaid, and that the advertisement of which the annexed is a true copy was published in the regular editions of said weekly newspaper three times, on the following dates July 20, 27, and August 3, 1951.

/s/ Edwin H. Evans,
Manager.

Sworn to and subscribed before me Aug. 6, 1951.

/s/ Anthony A. Emmet,
Notary Public, District of Columbia.

COPY OF NOTICE

Roberts B. Larson, Attorney
800 National Press Bldg.

[Filed July 13, 1951. Harry M. Hull, Clerk.]

United States District Court for the District of Columbia

Od Wikar Christensson, Plaintiff v. Stig Bertil Hogdal and John A. Marzall, Commissioner of Patents, Defendants. Civil Action No. 2217-51.

The object of this suit is the obtaining of a patent based on plaintiff's United States Patent application, Serial No. 774,987, filed September 19, 1947. Said application and the U. S. Patent 2,427,858 to defendant, Stig Bertil Hogdal, were involved in Interference No. 85,709 instituted by the United States Patent Office on February 8, 1949. This suit also requests a ruling that Patent No. 2,427,858 is invalid. On motion of the plaintiff, it is this 13th day of July, 1951, ordered that the defendant, Stig Bertil Hogdal, Danderyd, near Stockholm, Sweden, cause his appearance to be entered herein on or before the fortieth day, exclusive of Sundays and legal holidays, occurring after the day of the first publication of this order; otherwise the cause will be proceeded with as in case of default. Provided, a copy of this order be published once a week for three successive weeks in The Washington Law Reporter, and the Washington Post before said day. (s) MATTHEW F. McGUIRE, Judge. [Seal.] Attest: HARRY M. HULL, Clerk, by Ella McDonald, Deputy Clerk. 29-3t

* * * *

40 Filed Sep 18 1951 Harry M. Hull, Clerk

Affidavit

I, Alicia L. Batchelder, being duly sworn depose and say:

That I am employed as a secretary in the Law Office of Roberts B. Larson;

That on July 26, 1951, I mailed, by registered mail, a Notice of Civil Action No. 2217-51, which was clipped from The Washington Post dated July 19, 1951, to Defendant Stig Bertil Hogdal;

That the Notice was mailed to the following address:

Stig Bertil Hogdal
Danderyd, near
Stockholm, Sweden

41 That the Notice mailed to Defendant Hogdal is identical to the one affixed to the reverse side of this Affidavit.

/s/ Alicia L. Batchelder

Sworn to and subscribed before me this 27th day of July, 1951.

/s/ H. S. Imirie,
Notary Public, D. C.

My Commission expires Nov. 30, 1954.

42 LEGAL NOTICE OF CIVIL ACTION NO. 2217-51
clipped from The Washington Post dated July 19,
1951.

Roberts B. Larson
Attorney for Plaintiff
800 National Press Bldg.
Washington, D. C.

UNITED STATES DISTRICT COURT for the District of Columbia. Od Wikar Christensson, plaintiff, versus Stig Hertil Hogdal and John A. Marzall, Commissioner of Patents, defendants. Civil Action No. 2217-51. Filed July 13, 1951. Harry M. Hull, Clerk. The object of this suit is the obtaining of a patent based on plaintiff's United States patent application, Serial No. 774,987, filed September 19, 1947. Said application and the U. S. Patent 2,427,858 to defendant, Stig Bertil Hogdal, were involved in Interference No. 85,709 instituted by the United States Patent Office on February 8, 1949. This suit also requests a ruling that Patent No. 2,427,858 is invalid. On motion of the

plaintiff, it is this THIRTEENTH DAY OF JULY, 1951, ordered that the defendant, Stig Bertil Hogdal, Danderyd, near Stockholm, Sweden, cause his appearance to be entered herein on or before the fortieth day, exclusive of Sundays and legal holidays, occurring after the day of the first publication of this order; otherwise the cause will be proceeded with as in case of default. Provided, a copy of this order be published once a week for three successive weeks in the Washington Law Reporter, and The Washington Post before said day. (Signed) MATTHEW F. McGUIRE, Judge. Attest. HARRY M. HULL, Clerk. By Ella McDonald, Deputy Clerk. July 19, 26, August 2.

The undersigned declares that the article described on the other side was duly delivered on 18th August, 1951.

Le soussigné déclare que l'envoi mentionné d'autre part a été dûment livré le 19

Postmark of the office of destination

Timbre du bureau destinataire

SIGNATURE ¹

of the addressee:

du destinataire:

of the agent of the office of destination

de l'agent du bureau destinataire

Stig Hogdal, Norrköping, Sweden

¹ This receipt must be signed by the addressee, or if the regulations of the country of destination so provide, by the agent of the office of destination, and returned by the first mail direct to the sender.

Cet avis doit être signé par le destinataire, ou, si les règlements du pays de destination le comportent, par

*l'agent du bureau destinataire et retvoyé par le premier
courrier directement a l'expéditeur.*

U. S. Government Printing Office 5—11654

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Administration des Postes des États-Unis d'Amérique

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Registered article (.....) ⁽¹⁾ ⁽²⁾
Envoi recommandé

Parcel insured for \$.....⁽²⁾
Colis avec valeur déclarée de

Mailed at the post office of.....Wash D C.....
déposé au bureau de poste d

.....
on.....2/25....., 1951....., under No.....166043....
le 19 sous le No.

Mailed by M..... *R. B. Larson*
expédié par M

and addressed to M.....*S. B. Hogdal*.....
et adressé à M

at..... *Stockholm, Sweden*
à

¹ Indicate in the parenthesis the nature of the article
(letter, print, etc.).

*Indiquer dans la parenthèse la nature l'envoi (lettre,
imprimé etc.).*

² Strike out the indications not applicable.

Biffer les indications inutiles.

Return Receipt—*Avis de réception*

Postmark of the office returning the receipt

Timbre du bureau renvoyant l'avis

(To be filled in by the sender, who will indicate below his complete address.)

(*A remplir par l'expéditeur qui mentionnera ci-dessous son adresse complete.*)

M.....R. B. Larson
M

.....Natl. Press Bldg.
(Street and number)
(*Rue et numéro*)

at Wash., D. C.

à (Place of destination, in large characters)
(*Lieu de destination, en gros caractères*)

UNITED STATES OF AMERICA

États-Unis d'Amérique

POSTAL SERVICE

Service des postes

5—11654

. . . .

43 Filed Oct 5 1951 Harry M. Hull, Clerk

Motion By Hogdal To Dismiss

Now comes the defendant, Stig Bertil Hogdal, by counsel and moves, under the provisions of Rule 12(b), Rules of Civil Procedure for the District Courts of the United States, to dismiss the Complaint in the above entitled action for (a) lack of jurisdiction over the subject matter, (b) lack of jurisdiction over the person of the defendant Hogdal and (c) failure to state a claim upon which relief can be granted.

An oral hearing is requested.

Respectfully,

STIG BERTIL HOGDAL

By Cushman, Darby & Cushman
American Security Building
Washington 5, D. C.

By C. Willard Hayes
C. Willard Hayes

Of Counsel

/s/ William M. Cushman
William M. Cushman

* * * *

56 Filed Nov 16 1951 Harry M. Hull, Clerk

Final Order and Judgment Dismissing Complaint

The above-entitled cause having come on for hearing on separate motions to dismiss by the defendant, Stig Bertil Hogdal and the defendant, John A. Marzall, Commissioner of Patents, and the Court having heard oral arguments and having considered points and authorities and memoranda of the parties thereon, it is hereby:

ORDERED, ADJUDGED, AND DECREED this 16th day of November, 1951 that said motions be and hereby are sustained and that the complaint be and hereby is dismissed as to both defendants, with costs to defendants.

/s/ F. Dickinson Letts,
District Judge.

Approved:

/s/ E. L. Reynolds
E. L. Reynolds
Attorney for Defendant Marzall

* * * *

57 Filed Jan 11 1952 Harry M. Hull, Clerk

Notice of Appeal

Notice is hereby given this 11th day of January, 1952, that Od Wikar Christensson hereby appeals to the United States Court of Appeals for the District of Columbia from the judgment of this Court entered on the 16th day of November, 1951 in favor of Stig Bertil Hogdal and John A. Marzall, defendants, against said Od Wikar Christensson, plaintiff.

/s/ Roberts B. Larson
Attorney for
Od Wikar Christensson
Plaintiff

* * * *

58 Filed Jan 21 1952 Harry M. Hull, Clerk

Designation of Record

Now comes the plaintiff and designates the following records to be sent to the Court of Appeals:

1. Complaint—"Civil Action For Issuance of Patent Under R. S. 4915".
 2. Summons and return—relative to defendant, Marzall.
 3. Summons and return—relative to defendant, Hogdal, showing not found in District.
 4. "Motion to Dismiss" by defendant, Marzall—together with "Points and Authorities".
- 59 5. "Memorandum in Opposition to Motion to Dismiss of the defendant, John A. Marzall, Commissioner of Patents", together with "Points and Authorities".

6. Affidavit of Roberts B. Larson, filed July 12, 1951.
7. Order of Judge Maguire for publication, filed July 13, 1951.
8. Summons on defendant, Hogdal, and return showing acceptance of service on his behalf by William M. Cushman on August 2, 1951.
9. Praecept of appearance by William Cushman, filed August 8, 1951.
10. Affidavit of F. W. Sullivan of publication by Washington Post.
11. Affidavit of Edwin H. Evans of publication by The Washington Law Reporter.
12. Affidavit of Alicia M. Batchelder, and attachment, relative to service by publication.
13. "Motion by Hogdal to Dismiss" and "Points and Authorities"—October 4, 1951.
14. "Plaintiff's Response to Dismiss by Hogdal to Dismiss" and "Points and Authorities"—October 15, 1951.
15. "Final Order and Judgment Dismissing Complaint"—November 16, 1951.
16. Reporters transcript of proceedings before Judge Letts on November 16, 1951.

/s/ Roberts B. Larson
 Roberts B. Larson
 Attorney for Plaintiff, Christensson

• • • •

61 Filed Jan 30 1952 Harry M. Hull, Clerk

Amendment to Designation of Record

Filed herewith is an undertaking on behalf of the Appellant, Od Wikar Christensson, in connection with his appeal of the above cause.

It is also requested that there be included in the Designation of Record a copy of the Designation of Record itself, and also the Notice of Appeal and this letter of transmittal.

Respectfully,

/s/ Roberts B. Larson
Attorney for Appellant
Od Wikar Christensson

1 UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA
OD WIKAR CHRISTENSSON, Plaintiff,
v.
STIG BERTIL HOGDAL, Defendant,
v.
JOHN A. MARZALL, Commissioner of Patents,
Defendant.

Civil Action No. 2217-51

Washington, D. C.,

Friday, November 16, 1951.

The above-entitled matter came on for further hearing at 10:00 o'clock a.m., Friday, November 16, 1951, in the United States District Court for the District of Columbia, in the Court House in the City of Washington, District of Columbia,

BEFORE:

HONORABLE F. DICKINSON LETTS, Judge, United States District Court for the District of Columbia.

APPEARANCES:

ROBERTS B. LARSON, ESQUIRE,
On behalf of the Plaintiff;

2 MESSRS. CUSHMAN, DARBY & CUSHMAN,
By WILLIAM M. CUSHMAN, ESQUIRE

C. WILLARD HAYES, ESQUIRE, of counsel,
On behalf of Defendant Stig Bertil Hogdal,

E. L. REYNOLDS, ESQUIRE,
Solicitor, United States Patent Office,
On behalf of John A. Marzall,
Commissioner of Patents.

3 PROCEEDINGS

THE DEPUTY CLERK OF COURT: Are there any preliminary matters?

MR. HAYES: If Your Honor please, in the case of Christensson v. Hogdal and Marzall, the Court sustained the motion to dismiss on November 13th, and I have a final order and judgment dismissing the complaint which I would like to present to Your Honor. The other parties have notice of it. I understand it was not approved by counsel for plaintiff. I think this is in accordance with the decision of Your Honor.

THE COURT: Yes, sir, it seems to be in order.

MR. LARSON: May it please the Court, I am submitting this alternate form of order for this reason; Your Honor will recall that the motion to dismiss by the Commissioner of Patents related only to certain paragraphs of the bill. There has been no contention by either of the defendants that the bill did not contain or recite an adequate cause of action for a 4915 case. The only objection was that there was more than enough in that, as Your Honor has now ruled, of what was another remedy re-

quested and, under those circumstances, since the defendant would not be put to any additional proof at all, I am suggesting that we be given leave to amend and delete the objectionable portions from the bill and from the prayers.

MR. HAYES: Your Honor, it seems to me that this complaint was fatally defective from the very beginning in asking for more than the statute permitted and was, therefore, outside the statute in that it was seeking other remedy and, therefore, this Court never acquired any jurisdiction of the cause of action set forth in the complaint, or any jurisdiction over this defendant, and the complaint cannot be amended. A new complaint, if anything, should be filed.

There is no motion to amend pending before this Court, and I believe this is a proper form of final decree this morning. I have not considered the form submitted this morning by plaintiff, but it seems to me this is not the kind of complaint that can be amended because the Court has never had jurisdiction of the subject matter, since the jurisdictional statute was not complied with initially.

MR. LARSON: If the Court please, in accordance with the 4915 statute this Court has jurisdiction. The bill recites certain facts, and there is no contention set forth by either of the defendants that the bill does not contain all the facts necessary for a 4915 case.

With respect to these objectionable paragraphs, if they are deleted then we have a simple 4915 case upon which this Court can decide the sole issue of priority. If we delete these additional paragraphs and the prayers from the case, then it should be obvious that the defendants would not have any burden to try issues in this case other than those which relate to the question of priority.

In other words, we think the surplusage—

5 THE COURT: Yes, but if you had that kind of case you could not have gotten Hogdal in here

under any pretext, and now you have him because you got the service under the special provision of the statute.

MR. LARSON: All that was necessary to have Hogdal in here under the 4915 statute is contained in those paragraphs of the bill and the prayers which would remain.

MR. HAYES: But, Your Honor, the point is that the complaint has not followed, did not comply with the statute. The complaint asked for additional remedies which the statute says the Court does not have jurisdiction over and, therefore, I think the filing of the complaint was a complete nullity and the Court has no jurisdiction of the action at all.

THE COURT: That is my understanding.

MR. LARSON: May it please the Court, I think in an instance of this kind we have to look to the doing of substantial justice. Here, if the motion is granted, and the complete complaint is dismissed, I think it would be a hardship on the defendant.

THE COURT: That might be, but the prayer for jurisdiction is statutory purely.

MR. LARSON: That is correct.

THE COURT: You have to come within the
6 statute regardless of how much harm results otherwise.

MR. LARSON: There is one case which has been referred to in behalf of the defendant Hogdal this morning, a case in this jurisdiction, I think it is Robinson v. Wayne, in which the statute was involved in which the Court of Appeals indicated that it would be permissible pleading to add an exclusive licensee as a defendant, and I think the rules of practice of freely amending where it hurts nobody should be applied here as well as in that case.

The time, of course, for filing a new bill has long since gone by, and if this were a question of adding something to the complaint, then I could see that Mr. Hayes'

position would be tenable, but where it only results in deleting something which was really surplusage and the defendants are not put to any further additional burden with respect to those deleted matters, I think only substantial justice can be done if we are permitted to amend to delete those paragraphs.

THE COURT: But I don't think I have the right to go beyond the terms of the statute. It seems to me that it is a jurisdictional question purely, and that jurisdiction arises out of the statute itself, where such statute must be strictly adhered to.

MR. HAYES: Yes, Your Honor, I agree that this complaint, since it did not comply with the statute,
7 did not confer jurisdiction on this Court, and I think the Court has no authority to permit the amendment.

THE COURT: That is my conception of it, so I will accept the first order.

MR. LARSON: May it please the Court, I would like to note an appeal on that.

THE COURT: Oh, yes, the Court is glad to have you take it up.

(Thereupon, the instant hearing was concluded.)

* * * *

No. 11,320
BRIEF FOR APPELLANT

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

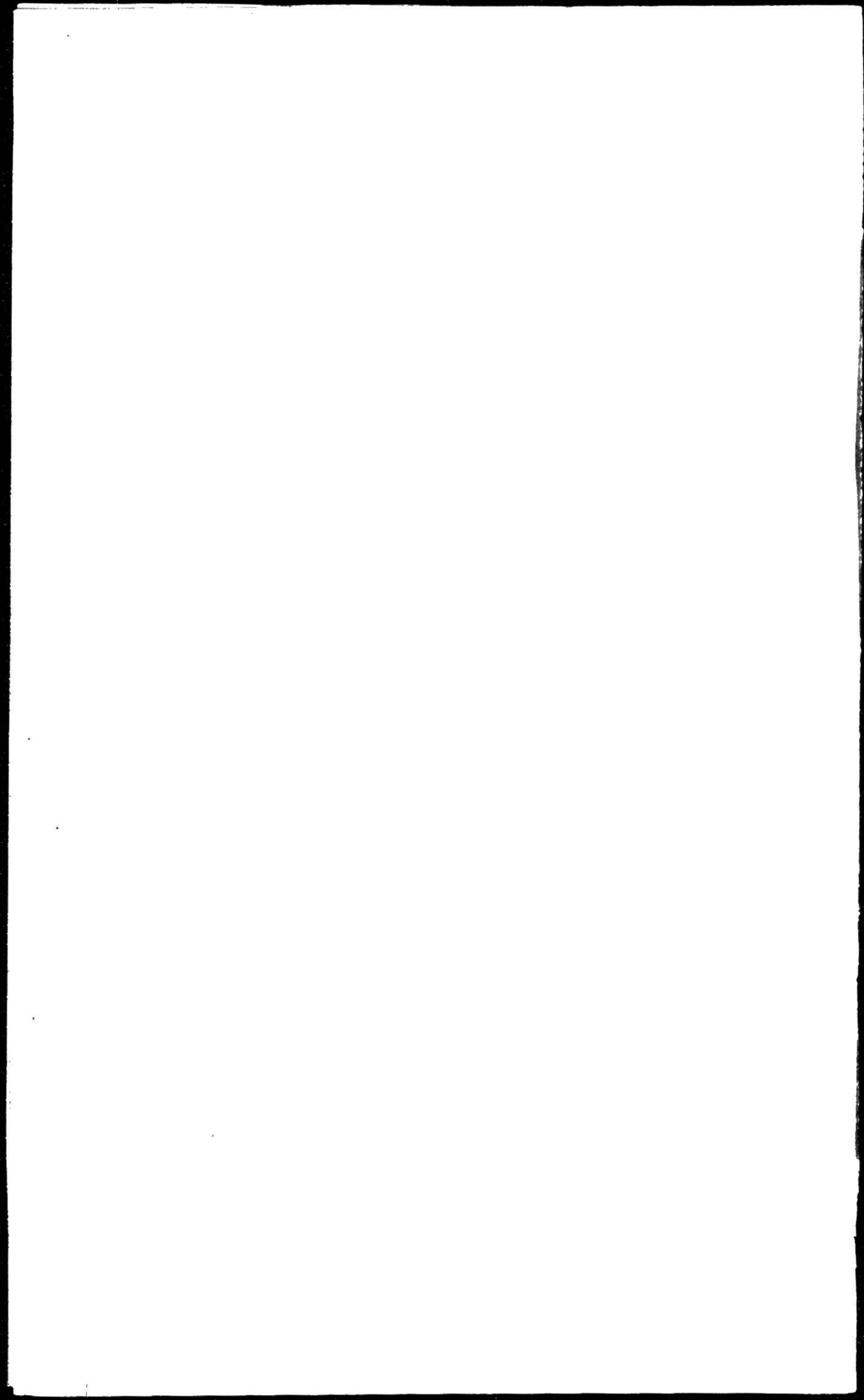
OD WIKAR CHRISTENSSON, *Appellant*,

v.

STIG BEETIL HOGDAL and JOHN A. MARZALL,
Commissioner of Patents, *Appellees*.

Appeal from the United States District Court
for the District of Columbia

ROBERTS B. LARSON,
National Press Building
Washington, D. C.
Attorney for Appellant.



STATEMENT OF QUESTIONS

The principal question is whether the language "without seeking other remedy" in 35 U.S.C. 72a bars the district court from jurisdiction of a civil action brought under 35 U.S.C. 63 and 72a by a dissatisfied applicant in a patent interference with a patentee because the complaint requested not only that plaintiff be declared entitled to priority but also that defendant's patent in interference be declared invalid.

A second question is whether the district court has jurisdiction of a civil action brought under 35 U.S.C. 63 by a dissatisfied applicant in a patent interference with a patentee who is a resident of a foreign country and where service on behalf of that patentee is accepted by his attorney here when presented with summons by the United States Marshal.

Another question is whether a plaintiff who has brought a civil action here under 35 U.S.C. 63 and 35 U.S.C. 72a as a dissatisfied applicant in a patent interference with a patentee, upon a ruling of the district court that the complaint in addition to requesting an award of priority requested "other relief" as would bar jurisdiction to the district court, may amend his complaint to delete therefrom as surplusage the request for such "other relief".

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United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 11,320

OD WIKAR CHRISTENSSON, *Appellant*,

v.

STIG BERTIL HOGDAL and JOHN A. MARZALL,
Commissioner of Patents, *Appellees*.

Appeal from the United States District Court
for the District of Columbia

BRIEF FOR APPELLANT

JURISDICTIONAL STATEMENT AND STATEMENT OF THE CASE *

The principal question herein involved is whether the United States District Court for the District of Columbia had jurisdiction of a civil action brought by a dissatisfied applicant of a Patent Office interference between that applicant and a patentee. The applicant is the appellant here. The patentee is an appellee. The other appellee is the Commissioner of Patents.

I

The jurisdictional aspects of this case are governed by two statutes. They are:

* Since the issues are primarily jurisdictional, the Statement of the Case is included as a part of this section of the brief.

1. 35 U.S.C. 63; R. S. 4915 (Act of February 9, 1893, C. 74, Sec. 9, 27 Stat. 436; Act of March 2, 1927, C. 273, Sec. 11, 44 Stat. 1336; Act of March 2, 1929, C. 488, Sec. 2(b), 45 Stat. 1476; Act of August 5, 1939, C. 451, Sec. 4, 53 Stat. 1212.), and

2. 35 U.S.C. 72a; (Act of March 3, 1927, C. 364, 44 Stat. 1394; Act of June 25, 1936, C. 804, 49 Stat. 1921.)*

II

The pleading showing the existence of jurisdiction in the United States District Court under these statutes is the complaint filed by the appellant below.**

The complaint sets out that the appellant Christensson (plaintiff below) is a subject of the King of Sweden and a resident of Sweden (Complaint ¶II—Joint Appendix—p. 2A) and that the appellee Hogdal (a defendant below) was also a subject of the King of Sweden and a resident of Sweden (Complaint ¶III—Joint Appendix—p. 3A).

It alleges that appellant filed an application in the United States Patent Office on September 19, 1947 (Complaint ¶IV—Joint Appendix—p. 3A), and that appellee, Hogdal, was granted United States patent No. 2,427,858, from which patent appellant, Christensson, copied claims and inserted them into his application and then requested that the Patent Office set up an interference proceeding to determine which of the two inventors was the prior and properly entitled to a patent (Complaint—¶¶ VII, VIII—Joint Appendix—pp. 3A, 4A).

* Section 113 of Title 28 referred to in the text has been replaced by Section 1932 of Title 28, as revised by the new Judicial Code, enacted June 25, 1948, effective September 1, 1948.

** The complaint is set forth in the Joint Appendix, pages 8 to 18, inclusive.

It alleges that the Patent Office declared the requested Interference No. 85,709 (Complaint ¶IX—Joint Appendix—p. 4A).

It alleges (Complaint—¶s XI, XII, XIII—Joint Appendix—pp. 6A, 7A, 8A) that in that Interference, both parties, for proof of priority, relied upon earlier filed patent applications which each had filed in Sweden, and upon the priority rights which accordingly would be available to them by virtue of certain statutes of the United States, and in particular, 35 U.S.C. 32, R.S. sec. 4887; Act of March 3, 1897, Mar. 3, 1897, ch. 391, sec. 3, 29 Stat. 693; Mar. 3, 1903, ch. 1019, sec. 1, 32 Stat. 1225; June 19, 1936, ch. 594, 49 Stat. 1529; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212.) and, 35 U.S.C. 101 (Act of August 8, 1946, C. 910, Sec. 1, 60 Stat. 940.—Public Law 690).

The complaint further alleges that, on the basis of rights as established by those statutes, the Patent Office shifted the burden of proof from Christensson to Hogdal and placed Hogdal under an order to show cause why judgment on the record should not be entered against him (Complaint— ¶XIV—Joint Appendix—p. 8A). Thereupon Hogdal filed a number of motions (Complaint—¶ XV—Joint Appendix—pp. 8A, 9A) and the matter was set down for final hearing before the Board of Interference Examiners.

It was alleged further that in the decision on final hearing, the Board of Interference Examiners held that while Christensson was entitled by statute to an earlier date of priority, nonetheless Hogdal should be awarded priority on the ground that the Swedish application on which Christensson relied did not disclose one of the elements of the counts of the Interference (Complaint—¶¶ XVI and XVII—Joint Appendix—pp. 9A, 10A).

The complaint further alleges that the appellant, Christensson, is the first, original, and sole inventor or dis-

coverer of the subject matter involved (Complaint—¶¶VI—Joint Appendix—p. 3A).

It alleges that on the basis of the record in the Interference, the appellee, Hogdal, was not entitled to the benefits of 35 U.S.C. 101 (Public Law 690) and that the according to him of such benefits was improper and erroneous and rendered his patent invalid (Complaint—¶¶XVIII, XIX, XX and XXI—Joint Appendix—pp. 10A, 11A).

On the basis of such facts, prayers 1 and 2 of the Complaint (Joint Appendix—p. 12A) ask that Christenson be adjudged to be the first inventor of the subject matter of the Interference and entitled to an award of priority and therefore to the issuance of a patent. Also, that the Commissioner of Patents be authorized and directed to issue such a patent to him.

Prayer 3 of the Complaint asks that the patent be cancelled from the records of the Patent Office as invalid and void and as having been granted contrary to United States statutes and in particular R. S. 4886, 4887, and Public Law 690* (Joint Appendix—p. 12A) and Prayer 4 requests that the Court declare the patent to be invalid and void for the same reason (Joint Appendix—p. 12A).

Other facts relating to the jurisdictional aspects of this case are as follows:

Upon the filing of the Complaint, service was made upon the defendant, the Commissioner of Patents (Joint Appendix—pp. 13A, 14A). The appellant, Hogdal, could not be found in the District of Columbia (Joint Appendix—p. 15A). Accordingly, as provided for in 35 U.S.C. 72a, service was made upon Hogdal by publication (Joint Appendix—pp. 16A, 17A, and 19A to 26A inclusive).

* U. S. Code—35 U.S.C. 31; 35 U.S.C. 32; and 35 U.S.C. 101, respectively. These are printed in full in the appendix to this brief.

Prior to the completion of service upon Hogdal by publication, service was made upon Hogdal by the United States Marshal, by serving his attorney here (Joint Appendix—pp. 18A, 19A).

The jurisdiction of the District Court was questioned by both defendants. Before the service by publication on Hogdal was effected, the defendant, the Commissioner of Patents, brought a motion to dismiss the Complaint on two grounds, namely, (1) for lack of jurisdiction due to the absence of a necessary party (Hogdal) and (2) as to paragraphs XVIII to XXI, inclusive (Joint Appendix pp. 10A, 11A) on the grounds that the Court lacks jurisdiction of the subject matter of those paragraphs under Revised Statute 4915 (35 U.S.C. 63) *supra*, and that, in any case, the Commissioner is not a proper party to an action seeking to adjudicate the validity of a patent (Joint Appendix—pp. 15A, 16A).

The motion to dismiss brought by the appellee, Hogdal, urged that the Complaint be dismissed on three grounds, viz: (1) lack of jurisdiction over the subject matter, (2) lack of jurisdiction over the person of the defendant, Hogdal, and (3) failure to state a claim upon which relief can be granted. (Joint Appendix—p. 26A.)

With regard to the motion to dismiss brought by the Commissioner of Patents, his contention that the Complaint should be dismissed for lack of jurisdiction due to the absence of the necessary party was not pressed after he learned that service had been had on the defendant, Hogdal, by publication.

The Commissioner continued to urge the second ground of his motion, namely, that the District Court lacked jurisdiction over the subject matter of Paragraphs XVIII to XXI, inclusive, as affecting the validity of the patent in the Interference and that the Commissioner of Patents

is not a proper party to an action seeking to adjudicate the validity of the patent.

With respect to the Commissioner's motion, the appellant urges that the service made on Hogdal, both by publication (Joint Appendix—pp. 16A, 17A and 19A to 26A inclusive) and by service by the United States Marshal on Hogdal's attorney (Joint Appendix—pp. 18A, 19A) was good and sufficient and that the District Court had jurisdiction of the cause by virtue of the allegations in the Complaint, the service on the parties, and in accordance with the language of the applicable statutes, 35 U.S.C. 33 and 35 U.S.C. 72a, *supra*.

With respect to the Motion of Hogdal to dismiss the complaint, appellant urges, and urged below that the Court had jurisdiction of the subject matter by virtue of statutes 35 U.S.C. 63 and 35 U.S.C. 72a; and jurisdiction over the person of the defendant, Hogdal, by virtue of those same statutes and by virtue of the service made on Hogdal, both by publication (Joint Appendix—pp. 16A, 17A and 19A to 26A inclusive) and by service on Hogdal's attorney (Joint Appendix—pp. 18A, 19A). The appellant relies upon these statutes, upon said service, and upon the allegations of the Complaint referred to above, to show that the District Court not only had jurisdiction but that the Complaint did state a claim upon which relief could be granted.

III

The Jurisdiction of This Court

In the lower court the motions to dismiss of both defendants were argued on November 8, 1951. When the final order was presented on November 16, 1951, (Joint Appendix—p. 27A) further argument was had, particularly with respect to the right of the plaintiff-appellant

to amend the complaint (Joint Appendix—pp. 30A, 31A, 32A and 33A). This appeal of the plaintiff-appellant, Christensson, is predicated upon the dismissal of the complaint as set forth in the final order and judgment (Joint Appendix—p. 27A) and on the ruling of the District Judge on November 16, 1951, denying to the appellant the right to amend the complaint (Joint Appendix—pp. 30A to 33A, inclusive).

The jurisdiction of this Court to entertain this appeal is provided for in 28 U.S.C. 1291; Act of June 25, 1948, C. 646, 62 Stat. 929.*

STATUTES INVOLVED

The questions presented by this appeal with respect to jurisdiction in the District Court are governed by 35 U.S.C. 63, *supra*, and 35 U.S.C. 72a, *supra*. They read as follows:

35 U.S.C. 63 (R. S. 4915)

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of

* Also, see *Vietti et al v. Wayne et al*, 78 App. D. C., 19, 136 F. 2d 771.

the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. (R.S. sec. 4915; Feb. 9, 1893, ch. 74, sec. 9, 27 Stat. 436; Mar. 2, 1927, ch. 273, sec. 11, 44 Stat. 1336; Mar. 2, 1929, ch. 488, sec. 2(b), 45 Stat. 1476; Aug. 5, 1939, ch. 451, sec. 4, 53 Stat. 1212.)

35 U.S.C. 72a

Upon the filing of a bill in the district court of the United States for the District of Columbia wherein remedy is sought under section 63 or section 66 of this title, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in section 113 of Title 28; provided that writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct. (Mar. 3, 1927, ch. 364, 44 Stat. 1394; June 25, 1936, ch. 804, 49 Stat. 1921.)

The jurisdiction of this Court of Appeals, with respect to this case, is based upon 28 U.S.C. 1291, Act of June 25, 1948 c. 646, 62 Stat. 929, which reads as follows:

The courts of appeals shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the District Court for the Territory of Alaska, the United States District Court for the District of the Canal Zone, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court.

Other statutes referred to in this brief will be found in the appendix hereto (not the Joint Appendix).

STATEMENT OF POINTS

1. The District Court had jurisdiction of this civil action by virtue of the provisions of 35 U.S.C. 63 and 35 U.S.C. 72a. The District Court erred in dismissing the complaint on the basis that these statutes did not confer jurisdiction upon it.

2. The language "without seeking other remedy" appearing in 35 U.S.C. 72a did not bar the District Court from jurisdiction of the action recited in the complaint merely because the complaint requested a determination of the related questions of priority and validity of the patent involved. The District Court erred in dismissing the complaint on the ground that jurisdiction was denied it because appellant had sought "other remedy".

3. Where the facts relating to priority in an interference between an applicant and a patentee necessarily affect the question of validity of the patent involved, a plaintiff in a R.S. 4915 (35 U.S.C. 63) action who requests a determination of both priority and validity based on those facts is not "seeking other remedy" than that provided for in R.S. 4915 (35 U.S.C. 63). The District Court erred in holding that plaintiff, in request-

ing such a determination, was "seeking other remedy".

4. The District Court has jurisdiction of this cause in view of 35 U.S.C. 63 (R.S. 4915) alone and without benefit of 35 U.S.C. 72a, in view of the fact that Hogdal voluntarily submitted to the jurisdiction when his attorney accepted service upon him here by the United States Marshal. The District Court erred in ruling that jurisdiction was present, if at all, only because of the provisions of 35 U.S.C. 72a.

5. A complaint which contains allegations sufficient to meet the requirements of 35 U.S.C. 63 and also of 35 U.S.C. 72a with respect to service, and also contains other additional allegations which defendants claim "seek other remedy" can be amended in such manner as to delete the additional allegations. The District Court erred in denying to appellant the right to so amend to delete the surplusage, if any.

SUMMARY OF ARGUMENT

1. In an interference proceeding between an applicant and a patentee, where the Patent Office ruled in favor of the patentee, the dissatisfied applicant clearly has the right to an action in the District Court here under 35 U.S.C. 63 (R.S. 4915), and the Court has jurisdiction even though the defendant is resident of a foreign country, if the defendant is served in the District of Columbia or appears voluntarily. The defendant, Hogdal, submitted to the jurisdiction of the District Court under 35 U.S.C. 63 (R.S. 4915) when his attorney accepted service on his behalf from the United States Marshal.

2. Where a dissatisfied applicant in an interference proceeding has brought an action under 35 U.S.C. 63 (R.S. 4915) in the District Court here, and service is had on that defendant additionally by publication as provided

for in 35 U.S.C. 72a, it is clear that the District Court has jurisdiction.

3. The complaint in this case asks for determination of issues which all arise from one set of facts. A determination of the issue of priority in this interference, based on those facts, will necessarily result in a determination of the validity of the patent of the appellee, Hogdal. By requesting in the complaint a determination of such issues, plaintiff was not "seeking other remedy" than that provided for in 35 U.S.C. 63 (R.S. 4915).

4. Where, in an interference between an applicant and the patentee, the facts relating to the question of priority show that the patent involved was granted contrary to explicit provisions of United States statutes, the District Court in an action under 35 U.S.C. 63 and 35 U.S.C. 72a where such facts are alleged, has, upon proof of such facts, the power to so indicate and to rule that the patent is invalid. A prayer in the complaint that the District Court so rule is proper and is not "seeking other remedy".

5. Nor is it improper in the situation as set forth in the preceding paragraph that the complaint include a prayer that the Commissioner be directed to cancel the patent. The inclusion of such a prayer is not "seeking other remedy" any more than is the general prayer which asks "for such other and further relief in the premises as the merits of the case may require".

6. The language "without seeking other remedy" in 35 U.S.C. 72a is of doubtful meaning. The legislative history is not helpful. The hearings in Congress on the bill which, when passed became that statute, do not indicate the real intent of the Congress in employing this language.

7. The decision of this Court in *Continental Distilling Corporation v. Old Charter Distilling Company et al.*, 88

App. D. C. 72, 188 F. 2d 614, involving an interpretation of the language "without seeking other remedy" is directed to the same question, is sound, and appears to be controlling of the present case.

8. Granting *arguendo* only that the complaint here sought "other remedy", appellant is entitled in the interest of justice and as sanctioned by modern practice, to amend the complaint to delete as surplusage any paragraphs and prayers in which such "other remedy" was allegedly sought.

ARGUMENT

I

The appellant has met all of those requirements of 35 U.S.C. 63 (R.S. 4915) which would permit the District Court to decide this action on the merits.

The requirements of the statute, as applicable to this case are

1. That the appellant be a dissatisfied applicant against whom the board of interferences of the Patent Office has ruled.
2. That the appellant has not taken an appeal to the United States Court of Customs and Patent Appeals.
3. That the complaint in the District Court be filed within six months of the decision of the board of interference examiners.

The appellees do not dispute the fact that these requirements have been met by appellant.

A further requirement of this or any similar statute is, of course, that the court have jurisdiction over the adverse parties. Where as here, one adverse party, the appellee Hogdal, was not a resident of this jurisdiction,

jurisdiction over him could only be obtained if he appeared here and accepted service.

While Hogdal never has been in the District of Columbia, his attorney voluntarily accepted service by the U. S. Marshal upon him (Joint Appendix pp. 18A, 19A). By so doing, the requisites of the R. S. 4915 Statute were met and the District Court having jurisdiction, could have proceeded.

If, at the time of such service, it had been the desire of the appellee Hogdal to contest the jurisdiction of the court over his person, this could have been done solely by appearance by his counsel, without accepting service.

II

To provide for those instances in which an adverse party resident in a foreign country *, and cannot be found in the District of Columbia, or does not voluntarily submit to the jurisdiction of the District Court here, Congress passed a special statute, 35 U.S.C. 72a. It refers to actions under 35 U.S.C. 63 (R.S. 4915) and 35 U.S.C. 66 **, and confers jurisdiction on the U. S. District Court for the District of Columbia. It states that if upon the filing of a bill here under either 35 U.S.C. 63 or 66, "without seeking other remedy", it shall appear that there is an adverse party residing in a foreign country, service may be had by publication unless the adverse party voluntarily makes appearance.

Disregarding, for the moment, the language "without seeking other remedy" of 72a, it is clear that the service by publication on Hogdal (Joint Appendix pp. 16A, 17A and 19A to 26A, inclusive) is exactly such as 35 U.S.C.

* Or where adverse parties reside in a plurality of districts not embraced in the same state.

** Involving interfering patents—see appendix to this brief, p. 28.

72a provides for. Thus, regardless of the service on Hogdal by service on his attorney here (Joint Appendix pp. 18A, 19A) the requirements for jurisdiction under this statute were met.

III

The appellee Hogdal urged below that while all this was so, nonetheless the District Court did not have jurisdiction because appellant in filing his complaint under 35 U.S.C. 63 (R.S. 4915) had sought in that action another remedy in addition to that permitted by the R.S. 4915 statute. 35 U.S.C. 72a, Hogdal argued, thus barred the District Court from having jurisdiction because the complaint under R.S. 4915 had not been filed "without seeking other remedy".

Hogdal has placed great reliance on this contention and it was the principal ground for the dismissal of the complaint by the court below. That it is without real foundation can, we submit, be clearly demonstrated.

What is the "other remedy" which appellee Hogdal contends appellant sought in the complaint? Hogdal urges that this is an interference and that the issue to be decided is the issue of priority of invention. He urges that the complaint not only raises that issue, but also urges that his patent is invalid, and thus seek "other remedy".

It must be remembered, however, that this cause involves an interference between an applicant for patent and a *patentee*. If, in such an interference it be decided that the applicant is the prior inventor, such a holding by its very nature constitutes a ruling on the validity of the patent involved. The patentee, who had taken oath that he was the original and first inventor,* is now found not to be the original and first inventor.

* 35 U.S.C. 35; R. S. 4898.

Thus, the very facts which are essential to a determination of the issue of priority of invention between an applicant and a patentee bear heavily on the issue of the validity of the patent involved in the interference. In fact, a basic and underlying issue in such an interference is, in truth, the validity of the patent involved.

The facts alleged in the complaint in this case are directed to the issue of priority of the invention involved. The complaint alleges that both parties claimed, for priority purposes, the benefits which could be accorded to them by United States Statutes (R.S. 4887 and 35 U.S.C. 101, Public Law 690), which would give them priority dates based on the filing dates of their earlier filed Swedish applications (Joint Appendix pp. 6A, 7A).

Thus, who would be judged the prior inventor in the interference would be the first to have filed a Swedish application, provided the benefits of the filing date of such Swedish application was claimed by the party under the requirements of 35 U.S.C. 101, Public Law 690.

Thus, all of these facts alleged in the complaint relate to the essential issue of an interference, namely, priority. Since this is an interference between an applicant and a patentee, these facts necessarily bear on the question of the validity of the Hogdal patent.

There is not a single fact alleged in the complaint which was not a matter of record in the interference in the Patent Office. They were all submitted to the board of interference examiners in the consideration of the issues of the interference.

Is appellant "seeking other remedy" because he alleges those same facts in his complaint before the District Court?

Is appellant "seeking other remedy" because he requests the District Court to pass on the validity of the

Hogdal patent as affected by those facts which it must consider in determining priority?

We feel that this court will agree that the answers to both of these queries is definitely in the negative.

This court has had a number of cases involving constructions of the 35 U.S.C. 72a statute, and in some of them the desire to adjudicate all issues involved, has been expressed. Thus, in the case of *Robinson v. Wayne et al*, 78 App. D. C. 15, 136 F. 2d 767, a case which did not, however, mention the phrase "without seeking other remedy" the Court stated:

"The purpose of the statute is to make possible the adjudication of all issues involved, between all adverse parties, in one proceeding and in one form. The District of Columbia was selected by Congress as being the form in which this fundamental objective of equity can best be achieved, when adverse parties reside in a plurality of districts not within the same state".

This expressed principle of the courts that wherever possible all issues arising from a given set of facts should be tried in one proceeding and in one form is set forth also in the Federal Rules of Civil Procedure *. While the rule does not override specific jurisdictional requirements of a statute such as 35 U.S.C. 72a, nonetheless, in a R.S. 4915 action brought under the provisions of 72a, it is still the purpose to decide and adjudicate all issues involved, which are closely related and stem from the same facts.

This Court's attention is directed to a case decided by District Judge Morris in 1944, *Autogyro Company of America v. Kay Gyroplanes, Ltd.*, 55 F. Supp. 919, No. 2345. That was an action brought by a plaintiff against

* Rule 18 of Federal Rules of Civil Procedure. See page 30 this brief.

the defendant and two other defendants who were dropped. The suit was pursuant to R.S. 4915 (35 U.S.C. 63) and service was made in accordance with 35 U.S.C. 72a. The complaint called for "a declaration that the assignor of the plaintiff was the first, original and sole inventor of the subject matter of certain claims on which Letters Patent had been granted to the defendant as assignee of two defendants who had been dropped." The complaint called "for a further declaration that the letters patent so issued are therefore invalid and void, and that the plaintiff was entitled to receive letters patent respecting such subject matter."

While the language of the statute "without seeking other remedy" was not discussed, the defendant there had moved to dismiss to set aside the service provided for under Section 72a.

Judge Morris, in his decision, said:

"The principal contention of the defendant is that the matter in controversy, being the validity of a patent, is personal property and as such has its situs at the place which is the residence of its owner, and in this case such a place is beyond the jurisdiction of this court. The further contention is made that the statute (72a) was intended to apply only where there is a plurality of adverse parties as distinguished from a single adverse party".

Continuing, the court said:

"It is unnecessary to labor the question as to whether this is an action in personam or one in rem. When the Letters Patent here in question were issued to the defendant and accepted by it, such issue and acceptance were subject to all provisions of law respecting the question of validity and the rights of others to call such validity into question. The defendant cannot now be heard to assert that he did not assent to the applicable provisions of Title 35, Section 72a U.S.C.A. supra."

The Court denied the defendant's motion to set aside.

Similarly, in the present case, the appellant, Christensson, has asked for a declaration that he was the first, original and sole inventor of the subject matter of certain claims on which Letters Patent were granted to the appellee, Hogdal. And the appellant, Christensson, has further asked for a declaration that the Letters Patent issued to Hogdal are therefore invalid and void and further that he, Christensson, be entitled to receive Letters Patent respecting the subject matter.

Similar to the situation in the Autogyro case, the question of priority (between an applicant and the patentee) cannot help but raise "the question of the validity of the patent and the rights of others to call such validity into question." To call the validity into question in urging his own rights to a patent, cannot truthfully subject the appellant to the charge that he has sought other remedy. Moreover, it should be manifest that in raising the questions of priority and of validity, based as they are on the identical set of facts, appellant has in no way subjected the appellee defendant Hogdal to any additional burden of the type which the Congress may have had in mind when it placed in the statute the language "without seeking other remedy".

IV

Included in the facts alleged in the complaint and hearing directly on the question of the priority, is the fact that Hogdal, contrary to the provisions of 35 U.S.C. 101, Public Law 690, asked for the benefit of his *third* filed Swedish application, whereas such, that statute provides that a request may only be based on the *first* filed Swedish application. His failure to do so prevents him from being prior in this interference. The Commissioner of Patents disregarded the explicit provisions

of 35 U.S.C. 101 in that a request for the benefits of that law must be based on the first filed Swedish application.

These facts were of record in the Patent Office in this interference, and they are alleged in the complaint (Joint Appendix pp. 2A to 12A inclusive). They are important to the issue of priority, and they likewise necessarily affect the validity of the Hogdal patent.

To allege them was both necessary and proper. Nor was it "seeking other remedy" for appellant to urge the District Court in its prayer (Prayers 3 and 4—Joint Appendix p. 12A) to declare the real effect of those facts upon the validity of the Hogdal patent.

V

Where the alleged facts, if proven, are not only determinative of priority, but also show the patent in interference to be invalid, a prayer asking that that determination be given effect by having the patent cancelled is no more of the nature of "seeking other remedy" than is the common prayer requesting the court to grant such other relief as may be deemed appropriate in the premises.

VI

In employing the language "without seeking other remedy", the framers of the statute apparently were protecting defendants against the additional burden of defending causes of action such as, for example, having facts differing from those normally presented in a R.S. 4915 action, an infringement action. In an R.S. 4915 action, a defendant should not be forced to defend himself against charges of infringement or other issues unrelated to the purposes of a R.S. 4915 suit. Infringement causes should more properly be the subject of suits brought in

the jurisdiction where the defendant resides, or, where the infringement occurs. If the language "without seeking other remedy" in 35 U.S.C. 72a means that such infringement suits could not be coupled with R.S. 4915 actions, the objective is a good one. If it were not for such a provision, defendants residing in many parts of the United States and abroad could, under the guise of a R.S. 4915 action, be brought within the jurisdiction of the U. S. District Court for the District of Columbia and subjected to suit on wholly unrelated facts and issues.

Presumably, the language "without seeking other remedy" could have still another meaning. It could mean that the District Court should not entertain jurisdiction where a plaintiff has previously sought the remedy provided for in R.S. 4911 (35 U.S.C. 59a) by bringing an appeal to the United States Court of Customs and Patent Appeals. This meaning would seem to be supported by the language of R.S. 4915 itself which states that a dissatisfied applicant may have relief under R.S. 4915 "unless appeal has been taken to the United States Court of Customs and Patent Appeals".

Unfortunately, the Congressional hearings on the bill which, when passed, became 35 U.S.C. 72a, are not very helpful in explaining the intent of the Congress in employing the language "without seeking other remedy".

While there was a great deal of testimony regarding the bill (H.R. 6252—69th Congress, 1st Session), the only discussion relative to the language "without seeking other remedy" was between two witnesses who were well-known Washington patent lawyers, Mr. L. D. Underwood and Mr. Karl Fenning. That discussion* reads as follows:

* Hearing before The Committee on Patents, House of Representatives, Sixty-Ninth Congress, First Session on H.R. 6252 and H.R. 7087, February 4, 1926.

"Mr. Underwood: * * * The only other thing, I think perhaps these words 'without seeking other remedy' might cause a little uncertainty as to what it means. I suppose it means if you do not bring suit anywhere else under 4915—

"Mr. Fenning: No, it means if you do not bring an infringement suit. But if you do not bring a man in here under the guise of Section 4915 and then try to sue him for infringement.

"The Chairman: 'Wherein the remedy is sought under * * *' and then it mentions these two sections."

Now, admittedly, this is not very enlightening. Here we have two patent lawyers differing as to the meaning of the term in question. Mr. Underwood believed that the language means that action could not be brought against a defendant by a plaintiff who had already brought suit under R. S. 4915 against the same defendant in another jurisdiction. This is not an illogical interpretation.

Mr. Fenning's explanation is not at all helpful as applied to the present situation. He said that the language means that a plaintiff could not bring suit under § 72a in this jurisdiction and in the same action sue the same defendant for *infringement*. It seems evident that Mr. Fenning was not referring to suits brought under § 4915 but rather to suits brought under § 4918 (35 U.S.C. 66). The latter type of suit is referred to in § 72a just prior to the words "without seeking other remedy". In a R.S. 4918 (35 U.S.C. 66) suit, the question is one of priority between two parties *both* of whom have patents. In the absence of the language "without seeking other remedy", either party, in addition to requesting a ruling on priority and validity of their patents, could include in the suit a charge of infringement if his opponent had manufactured, used or sold articles covered by the claims of the patent. This would place an undue hardship on the defendant and the prohibition of such tactics effected by the language "without seeking other remedy" makes good sense in such a situation.

But Mr. Fenning's remarks cannot be applicable to R.S. 4915 cases, since in accordance with the strict provisions of the R.S. 4915 statute, *only* a dissatisfied applicant, like Christensson, and *not* a patentee, like Hogdal, can avail himself of the jurisdiction conferred upon the district court by the statute.

One can hardly sue for infringement of a patent without having a patent.

VII

This Court in a case very similar to the present case has interpreted the language "without seeking other remedy" appearing in 35 U.S.C. 72a. We refer to the case of *Continental Distilling Corporation v. Old Charter Distilling Co., et al*, 88 App. D.C. 73, 188 F. 2d 614 (No. 10031), *supra*, decided December 7, 1950.*

In that case there were two registrants for trademarks. In the Patent Office there had been cancellation proceedings and the Commissioner had ruled that Continental was entitled to ownership of the mark and that the mark of the defendant, Old Charter, should be cancelled. Old Charter then brought suit in the United States District Court for the District of Columbia under R.S. 4915 (35 U.S.C. 63) "to enjoin the Commissioner from cancelling its mark,

* To appellant's knowledge, the only other court decision interpreting the language "without seeking other remedy" is the case of *Standard Oil Co. v. Pure Oil Co.*, 19 F. Supp. 833, where Judge Bailey of the District Court here held that the words "without seeking remedy" did not apply to an action between the parties in another court. The only reference to the language in question is contained in this statement by him:

"Inasmuch in my opinion the words 'without seeking other remedy' apply to 'other remedy' sought in the same suit, it is unnecessary to consider the question whether the defense of former suit pending can be raised by motion to dismiss, when the facts do not appear on the face of the bill * * *."

seeking also an adjudication that its Certificate of Registration No. 321,823 * * * is good and valid in law, and that plaintiff is the sole and exclusive owner of said Certificate, of the trade-mark Old Charter set forth therein, and of the good will and business thereof and connected therewith, in and throughout the United States of America". Continental, a defendant, was served with process in Delaware. The District Court found for Old Charter and Continental took an appeal to this Court.

Judge Wilbur K. Miller, speaking for the Court, stated that in this case "two distilling companies, conceding their registered trade-marks for whiskey to be confusingly similar, are contending for *priority*."* After reviewing the facts set forth above, the Court held, first, that Old Charter had a right of action under Revised Statute 4915; second, that service under Section 72a gave the Court jurisdiction. Third, the Court stated:

"Continental makes the further point that the action cannot be said to be one in which remedy is sought under Section 4915 "without seeking other remedy"; that therefore Section 72a of Title 35 of the Code does not apply. The complaint here did not 'seek other remedy' in our view. An injunction against the cancellation of the trade-mark was the remedy properly sought under Section 4915 as construed by the Baldwin case.** The only other relief prayed for was that the Old Charter Company be adjudged the owner of the mark. This was not the seeking of 'other remedy' but was an essential prerequisite to the right to an injunction. Obviously, the District Court could not enjoin the Commissioner from cancelling the mark without first determining the appellee was the lawful owner of it. So we conclude no 'other remedy' was sought."

* Emphasis supplied.

** *United States ex rel. The Baldwin Company v. Robertson*, 1924, 265 U. S. 168, 44 S. Ct. 508, 68 L. Ed.

The Court affirmed the judgment of the District Court.

The similarity between that case and the present case is striking. Both cases involve a question of priority. Accordingly, both also involve the validity of a Patent Office grant. In the decided case the grant was a registered trade-mark, while in the present case the grant is the Letters Patent granted to the appellee, Hogdal. The facts relating to the question of priority in both cases were obviously very closely related and essential to the question of the validity of the grant. It was, therefore, not "seeking other remedy" for the plaintiff in both cases to urge that the facts determinative of question of priority were controlling and obviously affected the question of validity. In each of the cases there was no additional burden for the defendant to meet. The facts with respect to priority were the same as those relating to validity. To permit them to be tried and determined in the same civil action was not contrary to the language of the statute, "without seeking other remedy", but was in fact carrying out the very purpose of the statute (as expressed in *Robinson v. Wayne et al*, supra), that is, "to make possible the adjudication of all issues involved, between all adverse parties, in one proceeding and in one forum".

Unfortunately, the decision of this Court in the Continental case was not known to appellant when argument was presented to the Court below. It would appear that the holding of this Court in the Continental case is sound and is clearly applicable to the present situation and that the District Court would never have granted the defendant Hogdal's motion to dismiss, had the case been called to the Court's attention.

VIII

In view of this Court's decision in the Continental case (*Continental Distilling Corporation v. Old Charter Distilling Co. et al.*, supra) appellant believes that it is hardly

necessary to urge that the District Court erred in denying to him the right to amend the complaint. Nonetheless, a brief argument on the point may be in order.

When the District Judge ruled the complaint did "seek other remedy", appellant's counsel urged (Joint Appendix pp. 31A, 32A) that he be permitted to amend the complaint to delete those allegations and prayers which, in the Court's opinion, indicated appellant was "seeking other remedy". These were the allegations and prayers referring to the question of validity of the Hogdal patent (§§ XVIII to XXI and Prayers 3 and 4 of complaint—Joint Appendix pp. 10A-12A). The District Court denied this request to amend (Joint Appendix pp. 31A-34A).

Amendment, by deleting allegations unnecessary for an R.S. 4915 case, should have been permitted in the interests of equity and justice and to prevent a technical interpretation of a statute from barring the trial and determination of important issues.

Amendments, particularly those which involve only deletion of what must be regarded as surplusage, should be permitted in the absence of some vital and specific restriction to making them.

CONCLUSION

The considerations presented in this brief point clearly to the conclusion that the District Court erred in dismissing the complaint for lack of jurisdiction and in denying appellant the right to amend.

The judgment of the District Court should be reversed and the case remanded for trial.

Respectfully submitted,

ROBERTS B. LARSON,
Attorney for Appellant.

APPENDIX FOR BRIEF

35 U.S.C. 31; R. S. 4886.

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R.S. sec. 4886; Mar. 3, 1897, ch. 391, sec. 1, 29 Stat. 692; May 23, 1930, ch. 312, sec. 1, 46 Stat. 376; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212.)

35 U.S.C. 32; R. S. 4887.

No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 31 of this title, and six months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, conven-

tion, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country: *Provided*, That the application in this country is filed within twelve months in cases within the provisions of section 31 of this title, and within six months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on any application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than one year prior to such filing. (R.S. sec. 4887; Mar. 3, 1897, ch. 391, sec. 3, 29 Stat. 693; Mar. 3, 1903, ch. 1019, sec. 1, 32 Stat. 1225; June 19, 1936, ch. 594, 49 Stat. 1529; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212.)

35 U.S.C. 35; R. S. 4892.

The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, or consul holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States. (R.S. sec. 4892; Mar. 3, 1903,

ch. 1019, sec. 2, 32 Stat. 1226; Apr. 5, 1906, ch. 1366, sec. 3, 34 Stat. 100; May 23, 1930, ch. 312, sec. 3, 46 Stat. 376.)

35 U.S.C. 59a; R. S. 4911.

If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 63 of this title. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals: *Provided*, That such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 60 of this title, file notice with the Commissioner of Patents that he elects to have all further proceedings, conducted as provided in section 63 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a bill of equity under said section 63, in default of which the decisions appealed from shall govern the further proceedings in the case. (R.S. sec. 4911; Mar. 2, 1927, ch. 273, sec. 8, 44 Stat. 1336; Mar. 2, 1929, ch. 488, sec. 2(a), 45 Stat. 1476; Aug. 5, 1939, ch. 451, sec. 3, 53 Stat. 1212.)

35 U.S.C. 66; R. S. 4918.

Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both of the patents void in whole or in part, upon any ground, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person ex-

cept the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. (R.S. sec. 4918; Mar. 2, 1927, ch. 273, sec. 12, 44 Stat. 1337.)

35 U.S.C. 101 (*Public Law 690*)

The rights of priority provided by section 32 of this title, for the filing of applications for patent for inventions, discoveries, and designs, which rights had not expired on the 8th day of September 1939, or which rights have arisen since the 8th day of September 1939, shall be, and the same are, extended until the expiration of a period of twelve months from August 8, 1946, in favor of the citizens of the United States and of citizens or subjects of all countries which have extended, or which on August 8, 1946, extend or which within said period of twelve months shall extend substantially reciprocal privileges to citizens of the United States, and such extension shall apply to applications upon which patents have been granted, as well as to applications pending on August 8, 1946, or filed within the period specified herein: *Provided*, That no such extension shall apply to any patent unless a request in writing was made therefor during the pendency of the application for such patent in the United States Patent Office, or within twelve months after August 8, 1946, which request must be accompanied by (1) a copy of the original foreign application, certified to by the patent office of the country in which it was filed, but if the original foreign application has been destroyed, other evidence pertaining thereto may be accepted; (2) a sworn translation of the same if it is not in the English language; and (3) if the foreign application was not made by the inventor himself, an affidavit by the applicant or patentee stating that such application was filed for his benefit or on his behalf and that such procedure is in accordance with the procedure in the foreign country: *Provided further*, That no patent granted or validated by reason of any such extension shall in any way furnish a basis of claim against the Government of the United States; *Provided, further*, That such extension shall in no way

abridge or otherwise affect the right of the United States, or of any person, firm, association, company, or corporation, who, before August 8, 1946 was bona fide in possession of any rights in or under patents or applications for patents conflicting with rights in patents granted or validated by reason of such extensions to exercise such rights by itself or himself personally, or by such agents, or licensees as derived their rights from it or him before August 8, 1946, to the extent that they shall not be amenable to any action for infringement of any patent granted or validated by reason of such extension.

A patent shall not be refused on an application coming within the provisions of this section, nor shall a patent granted on such application be held invalid, by reason of the invention having been patented or described in any printed publication or in public use or on sale in the United States more than one year prior to the filing of the application in the United States, unless such patent or publication or such public use or sale was prior to the filing of the foreign application upon which the right of priority is based. (Aug. 8, 1946, ch. 910, sec. 1, 60 Stat. 940.)

Federal Rules of Civil Procedure, Rule 18. Joinder of Claims and Remedies

(a) *Joinder of Claims.* The plaintiff in his complaint or in a reply setting forth a counterclaim and the defendant in an answer setting forth a counterclaim may join either as independent or as alternate claims as many claims either legal or equitable or both as he may have against an opposing party. There may be a like joinder of claims when there are multiple parties if the requirements of Rules 19, 20, and 22 are satisfied. There may be a like joinder of cross-claims or third-party claims if the requirements of Rules 13 and 14 respectively are satisfied.

BRIEF FOR APPELLEE, HOGDAL.

IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 11,320

OD WIKAR CHRISTENSSON, *Appellant,*

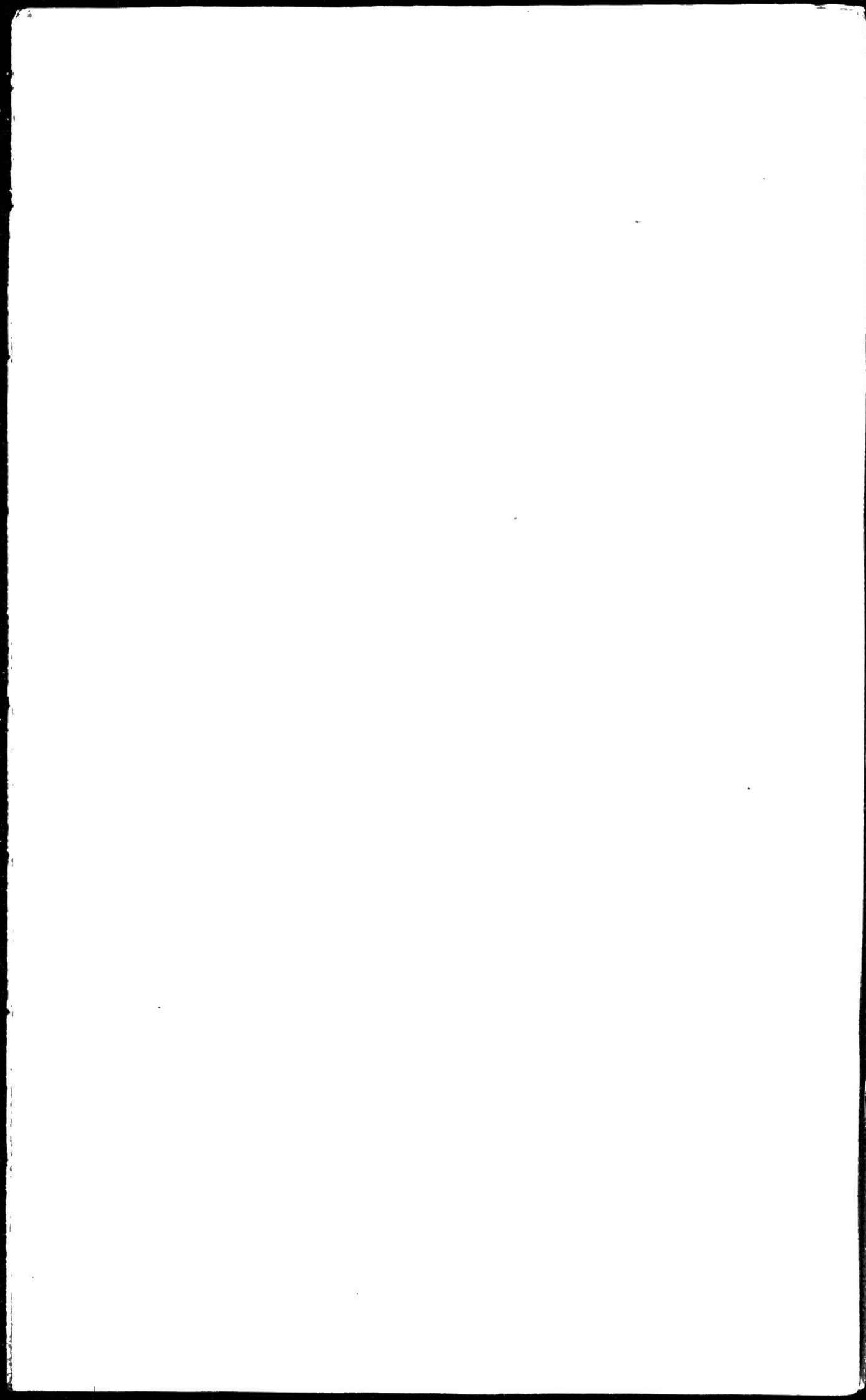
v.

STIG BERTIL HOGDAL and JOHN A MARZALL,
Commissioner of Patents, *Appellees.*

Appeal from a Judgment in the United States District
Court for the District of Columbia Dismissing the
Complaint.

CUSHMAN, DARBY & CUSHMAN,
American Security Building,
Washington, D. C.,
Attorneys for Appellee, Hogdal.

C. WILLARD HAYES,
Of Counsel.



STATEMENT OF QUESTIONS PRESENTED.

In the opinion of appellee, the questions presented are:

1. Does a complaint setting forth "a first cause of action" under R. S. 4915 (35 U. S. C. 63) seeking an award of priority of invention and a judgment based therein authorizing the Commissioner of Patents to issue a patent to plaintiff, and a "second cause of action" seeking a judgment, not based on a claim of priority, that defendant's patent is invalid and directing the Commissioner to cancel the patent, comply with 35 U. S. C. 72a, giving the local District Court jurisdiction over a foreign defendant, only upon a complaint under R. S. 4915 (35 U. S. C. 63) "without seeking other remedy"?

2. Where the special jurisdictional statute, 35 U. S. C. 72a, gives the local District Court jurisdiction over a foreign defendant only in actions under R. S. 4915 and R. S. 4918 (35 U. S. C. 63 and 66) "without seeking other remedy", and where a plaintiff failed to comply therewith, by adding to a "first cause of action" under R. S. 4915, a "second cause of action", seeking other relief, unrelated to the relief sought or permitted under R. S. 4915, did the District Court abuse its discretion in holding that the Complaint conferred no jurisdiction upon the Court and could not be amended, retroactively to confer a non-existing jurisdiction, after the six month period of limitation for filing under R. S. 4915 had expired?

3. Does the acceptance of a summons and complaint by an attorney for a non-resident defendant constitute a waiver of defendant's right to challenge venue in the District Court or to challenge the jurisdiction of the District Court over the subject matter of the Complaint?

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IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 11,320

OD WIKAR CHRISTENSSON, *Appellant*,

v.

STIG BERTIL HOGDAL and JOHN A MARZALL,
Commissioner of Patents, *Appellees*.

BRIEF FOR APPELLEE, HOGDAL.

Appeal from a Judgment in the United States District
Court for the District of Columbia Dismissing the
Complaint.

COUNTER-STATEMENT OF THE CASE.

There was nothing unusual about the interference in the Patent Office, in which plaintiff and defendant Hogdal were involved. Hogdal's application for patent was filed on August 16, 1943 (Jt. App. 3A)*, while plaintiff's was not

* The pages of the Joint Appendix will be referred to as Jt. App. A.

filed until September 19, 1947, only four days before the grant of defendant's patent, No. 2,427,858 on September 23, 1947. However, plaintiff claimed the benefit of a prior Swedish application for priority purposes, and his application was placed in interference with defendant's patent, to determine the question of priority of invention as to the subject matter of claims 4 and 5 of the patent. (Jt. App. 4A, Paragraphs VII and VIII).

After interlocutory proceedings in the Patent Office, the Primary Examiner tentatively gave plaintiff the benefit of November 13, 1940 as his filing date in Sweden, which was ahead of defendant's United States filing date and his prior Swedish filing date of April 2, 1941. (Jt. App. 8A, Paragraph XIV).

However, at final hearing, the Board of Interference Examiners, upon a review of the entire record, including a translation of plaintiff's Swedish application, decided that he was not entitled to the date of November 13, 1940, for the simple reason that the prior Swedish application *did not disclose* the subject matter of the counts of the interference and, therefore, did not disclose the same invention as claims 4 and 5 of the Hogdal patent. In other words, the Board of three Examiners of Interferences decided unanimously that the interference should never have been declared in the first place. Thus, the award of priority of invention to defendant and the refusal to grant a patent to plaintiff was based solely on the *lack of disclosure* of the invention in plaintiff's application.

Plaintiff was dissatisfied with this decision of the Board of Interference Examiners and sought a review thereof under R. S. 4915 (35 U. S. C. 63) which provides that such a dissatisfied applicant may have remedy by bill in equity, if filed within six months after such decision, and that the Court may adjudge that an applicant, such as plaintiff, is entitled, according to law, to receive a patent for his invention. Since defendant Hogdal was a resident of Sweden, venue could not have been laid in the local District Court, except for the provisions of 35 U. S. C. 72a, granting that

Court jurisdiction upon a Complaint under R. S. 4915, without seeking other remedy. An order permitting service by publication on the Swedish defendant was signed by Judge McGuire on July 13, 1951. (Jt. App. 17A). Before expiration of the period of publication specified in Judge McGuire's order, service of the Complaint and Summons was accepted by the local attorney for defendant, Hogdal. (Jt. App. 18A)

Plaintiff's dissatisfaction with the decision of the Board of Interference Examiners was the sum and substance of the "first cause of action" recited in Paragraphs I—XVII of the Complaint (Jt. App. 2A-10A). Plaintiff simply sought a review by the District Court of the decision of the Board of Interference Examiners, as to the sufficiency of the disclosure of his Swedish application. The "first cause of action" was the usual one under R. S. 4915 (35 U. S. C. 63) growing out of an interference, and the first and second prayers (Jt. App. 12A) sought the usual relief.

Apparently, however, plaintiff lacked confidence in the merits of this "first cause of action", predicated upon the sufficiency of his Swedish application, since he added a "second cause of action", (Jt. App. 10A, 11A), in which he made a collateral attack upon defendant's patent, not based on any claims of his own priority of invention, but predicated exclusively on a contention that defendant had failed to comply with the Boykin Act, Public Law 690 (35 U. S. C. 101) and R. S. 4887 (35 U. S. C. 32).

A review of Paragraphs XVIII—XXI of the Complaint demonstrates that this "second cause of action" is entirely unrelated to the "first" and seeks an adjudication (Prayer No. 4, Jt. App. 12A) that the Court declared defendant's patent "invalid and void and as being obtained contrary to and in disregard of specific provisions of statutes of the United States", without the slightest reference to any alleged priority of invention in plaintiff. As a further item of relief, plaintiff sought a judgment (Prayer 3, Jt. App. 12A) that the Commissioner of Patents be directed to cancel from the records of the Patent Office, the patent to defendant Hogdal as invalid and void and as granted con-

trary to Pubile Law 690, again without reliance upon any alleged priority of invention in plaintiff.

Thus, the Complaint in this case sets up two independent and distinct causes of action, based on different facts and different legal theories. The first is predicated upon a claim of priority and seeks a judgment authorizing the grant of a patent to plaintiff. The second is predicated upon an alleged failure of defendant to comply with the requirements of the Boykin Act and seeks a judgment declaring the Hogdal patent invalid and requiring the Commissioner to cancel the patent, without reference to plaintiff's alleged priority.

As demonstrating the independence of the two causes of action, it should be noted that, even though plaintiff lost on the first action, for failure to establish that his Swedish application disclosed the invention in issue, he might prevail in the second cause of action (if the District Court had jurisdiction), should he be able to establish defendant's non-compliance with the Boykin Act. In other words, under the guise of an action under R. S. 4915, plaintiff is seeking to invalidate defendant's patent even though plaintiff is not, in the legal sense, the prior inventor.

Defendant moved to dismiss the Complaint (Jt. App. 26A) under the provisions of rule 12b of the Federal Rules of Civil Procedure, on the ground that the Court had no jurisdiction over the subject matter, or over the person of the defendant, and for failure of the Complaint to state a claim upon which relief could be granted. On November 13, 1951 (Jt. App. 31A), Judge Letts sustained the motion, holding that the Court had no jurisdiction over the cause of action, since the Complaint did not comply with the jurisdictional statute, 35 U. S. C. 72a, giving the Court jurisdiction in an action under R. S. 4915 over a foreign resident *only* in a case seeking relief under R. S. 4915, "*without seeking other remedy*".*

* Italics added, throughout.

Prior to the decision sustaining the motion to dismiss, plaintiff had made no motion to amend. Only at the hearing before Judge Letts on the form of the Final Order and Judgment, after the decision sustaining the motion, did plaintiff suggest that the complaint be amended by deleting the paragraphs demanding "other relief". The suggestion was overruled and the Final Order entered on November 16, 1951 (Jt. App. 27A).

SUMMARY OF ARGUMENT.

1. The acceptance of service by defendant's counsel did not constitute a waiver of the right to challenge venue in the District Court or jurisdiction over the subject matter of the Complaint. Under Rule 12 of the Federal Rules of Civil Procedure, special appearances are unnecessary, and a voluntary appearance does not waive any objections as to venue and jurisdiction.

2. Service by publication cannot confer jurisdiction over the person of a foreign defendant upon a complaint which fails to comply with the special jurisdictional statute authorizing the service by publication, and such service cannot deprive the defendant of his right to challenge the compliance of the Complaint with the statute.

3. The only relief authorized by R. S. 4915 (35 U. S. C. 63) is a judgment that plaintiff is entitled, according to law, to receive a patent for his invention. In such an action, the Court may not adjudicate the validity of a defendant's patent, or order the Commissioner of Patents to cancel the same.

4. The special jurisdictional statute, conferring jurisdiction upon the local District Court over a plurality of adverse party defendants residing in different states and over an adverse party defendant residing in a foreign country, specifically limits the jurisdiction to an action upon a complaint under R. S. 4915 "*without seeking other remedy*". If other remedy is sought, the Court has no jurisdiction over such adverse party defendants. The Complaint in the pres-

ent case seeks such other remedy, in the form of a judgment of invalidity of defendant's patent and a cancellation thereof by the Commissioner of Patents. Therefore, the Court has no jurisdiction over the Complaint and no jurisdiction over the person of the defendant, a resident of Sweden.

5. The other remedy sought under plaintiff's "second cause of action" is unrelated to the relief sought or permitted by the first cause of action under R. S. 4915 (35 U. S. C. 63), is not based on a claim of priority of invention in plaintiff, but is based upon a different set of facts and a different legal theory, namely, defendant's alleged failure to comply with the Boykin Act, Public Law 690 (35 U. S. C. 101).

6. If the Court had jurisdiction over the person of the defendant, and if there existed a justiciable controversy over the validity of defendant's patent, and if the facts were as alleged in the "second cause of action", plaintiff might be entitled to a declaratory judgment of invalidity of defendant's patent, even though plaintiff failed to prove his own priority of invention and, therefore, was not entitled to receive a patent for his invention, the relief sought by the first cause of action under R. S. 4915; thus demonstrating the independence of the two causes of action and the "other remedy" sought by the second.

7. This Court's decision in *Continental Distilling Corporation v. Old Charter Distillery Co., et al*, 88 App. D. C. 73, 188 F. (2d) 614, relied upon by plaintiff-appellant is not a precedent, since the action under R. S. 4915 was predicated upon Section 9 of the Trade-Mark Act of 1905, as interpreted in *United States ex rel. The Baldwin Company v. Robertson*, 265 U. S. 168; did not involve an application for a patent or a trade-mark; and did not seek "other remedy" than that normally sought under the statutes there involved, as construed by the Supreme Court in the *Baldwin case*. Plaintiff there was not an applicant but was a registrant, owning a trade-mark registration which the Commissioner had ordered cancelled. Under the doctrine of

the *Baldwin* case, plaintiff was entitled to sue for an injunction against the Commissioner, enjoining him from cancelling plaintiff's registration. No "other remedy" was sought.

8. The District Court correctly refused to permit the plaintiff to amend the Complaint, after its decision sustaining Defendant's Motion to Dismiss and after the statutory period for filing a proper action under R. S. 4915 had expired. A complaint, such as the present one, which fails to comply with the special jurisdictional statute, confers no jurisdiction over the subject matter upon the Court in which it is filed; and the Court, having no jurisdiction over the complaint, cannot permit its amendment. The fatal error may be rectified only by the filing of a new complaint, but such a new complaint is barred by the statute of limitations.

ARGUMENT.

I.

Without citing any supporting authority, in the statutes, rules, or decisions, plaintiff contends (Br. 13)* that the acceptance of service by defendant's attorney of the summons and complaint conferred jurisdiction upon the Court over the person of the defendant and over the subject matter of the complaint. The unsupported contention is advanced that defendant could "contest the jurisdiction of the Court over his person * * * solely by appearance of his counsel without accepting service".

Plaintiff chooses to ignore Rule 13(b) of the Federal Rules of Civil Procedure, which specifically provides:

"* * * The following defenses may at the option of the pleader be made by motion: (1) lack of jurisdiction over the subject matter, (2) lack of jurisdiction over the person, (3) improper venue, (4) insufficiency of process, (5) insufficiency of service of process, (6) failure to state a claim upon which relief can be granted."

* Plaintiff-Appellant's brief will be referred to as Br. .

Acceptance of service does not waive any defense. Special appearances are no longer recognized or required under the Federal Rules of Civil Procedure.

Moore's Federal Practice, Second Edition, Vol. 2, pp. 2262, 2263 states:

"Special appearances are no longer necessary in any case. 'Rule 12 has abolished for federal courts the age-old distinction between general and special appearances'. (Orange Theater Corp. v. Rayherstz Amusement Corp., 139 F. 2d 871). A voluntary appearance does not waive the objection of lack of jurisdiction over the person. * * *."

In *McNutt v. General Motors Accept. Corp.*, 298 U. S. 178, 189, the Supreme Court said:

"* * *. The prerequisites to the exercise of jurisdiction are specifically defined and the plain import of the statute is that the District Court is vested with authority to inquire at any time whether these conditions have been met. They are conditions which must be met by the party who seeks the exercise of jurisdiction in his favor. He must allege in his pleading the facts essential to show jurisdiction. If he fails to make the necessary allegations he has no standing. * * *. If his allegations of jurisdictional facts are challenged by his adversary in any appropriate manner, he must support them by competent proof. And where they are not so challenged the court may still insist that the jurisdictional facts be established or the case be dismissed, and for that purpose the court may demand that the party alleging jurisdiction justify his allegations by a preponderance of evidence. * * *."

There is no merit to plaintiff's contention that the acceptance of service of process by counsel for defendant constituted a waiver of defendant's right to move to dismiss the Complaint.

II.

Plaintiff's second argument that the service by publication confers jurisdiction upon the Court, based upon his

statement, "disregarding, for the moment, the language 'without seeking other remedy' of 72a * * *", is meaningless, since that language in the special jurisdictional statute authorizing service by publication cannot be disregarded. We agree that service by publication, of a *proper* complaint may be effected under the provisions of 35 U. S. C. 72a. However, such a complaint must meet the specific requirements of the section, whereas the one in the present case is fatally defective as seeking "other remedy", in addition to that provided by R. S. 4915. Hence, the service by publication was not authorized by the statute.

III.

The District Courts of the United States have jurisdiction under the specific provisions of R. S. 4915 (35 U. S. C. 63) to grant one particular kind of relief and no other. The pertinent portions of the statute as far as the present case is concerned are:

" * * * whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant * * * may have remedy by bill in equity, if filed within six months after such * * * decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is *entitled*, according to law, to receive a patent for his invention * * *. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. * * *."

Thus, the only remedy provided by the statute is a judgment that the applicant is entitled to receive a patent for his invention. The Court is without jurisdiction to grant any other relief.

In *Illingworth v. Atha et al.*, 42 Fed. 141, 144, the Circuit Court for the District of New Jersey, in an action under R. S. 4915, against the prevailing party in an interference

and also against the Commissioner of Patents, refused to grant an injunction, restraining the first defendant from receiving a patent and restraining the Commissioner from granting a patent. The Court said:

“Nor can the like motion against the commissioner of patents be granted, and for two reasons: First, in my opinion, this court can derive no power to enjoin the commissioner from the statute relied upon by complainant. This is purely a statutory proceeding, and the court cannot go outside the statute which is the foundation of the action to assume to itself powers not found in the purview of the act. The section under consideration has but a single object,—to provide a way by which an unsuccessful applicant for letters patent, notwithstanding the rejection of his claim by the commissioner of patents, may obtain them through an adjudication, in favor of his right thereto, by a court of equity having cognizance of the subject-matter; and, as the object of the section is single, so is the power of the court plainly limited under it to the accomplishment of that object. The prayer of a bill of complaint exhibited to the court under and by virtue of this section would be for a decree that the complainant has established his right to have letters patent issued to him. *So far may the decree of the court go, but no further.* It may adjudge an issue of the letters, or it may declare the complainant to be without right. In either case, the power conferred by this section is exhausted. Nowhere can be gathered, either from the words of the section, nor from its spirit and purpose, an intention on the part of the national legislature to authorize an interference with the commissioner of patents, in the performance of his plain duty, by writ of injunction. * * *.”

In *Smith v. Carter Carburetor Corporation*, 130 F. (2d) 555, 560, the Circuit Court of Appeals for the Third Circuit cited the Illingworth case with approval in an action under R. S. 4915 and said:

“* * *. The patentability of the defendant's invention is not before us. Nor may the patent thereof

granted by the Commissioner be invalidated or revoked in a proceeding under R. S. Sec. 4915. See *Illingworth v. Atha*, C. C. N. J., 42 F. 141, 144. Consequently, we may not consider in this proceeding the question whether Ericson was entitled to the broad claims allowed him * * *."

IV.

The jurisdiction of the local District Court over a foreign defendant in an action under R. S. 4915 (35 U. S. C. 63) is conferred by a special jurisdictional statute, 35 U. S. C. 72a, which specifically limits the jurisdiction to a complaint under the section "without seeking other remedy". The pertinent portion of 35 U. S. C. 72a is as follows:

"Upon the filing of a bill in the District Court of the United States for the District of Columbia wherein remedy is sought under Section 63 or 66 of this title, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, * * * the Court shall have jurisdiction thereof * * *."

A complaint seeking remedy under R. S. 4915 and also seeking other remedy does not comply with the foregoing jurisdictional statute; the Court does not have jurisdiction of such a complaint; jurisdiction over the person of a foreign defendant cannot be secured; and such a complaint does not state a claim upon which relief can be granted.

The complaint in the present case seeks other remedy than that provided by R. S. 4915.

Each and every requirement of a special jurisdictional statute must be strictly complied with.

In *Klumb v. Roach*, 151 F. (2d) 374, 377, 380, the Circuit Court of Appeals for the Seventh Circuit affirmed the dismissal of an action under 4915 growing out of an interference in the Patent Office, because of the absence of an indispensable party. The Court said:

"* * *. It must be remembered that this is not an ordinary equitable action but is predicated solely upon a statutory provision which confers jurisdiction upon

the Court and fixes the rights of the parties. In order for plaintiff to bring himself within the terms of Section 4915 and before the court can adjudicate the rights of the parties, certain things must exist: (1) Plaintiff must have elected to proceed in a District Court rather than by appeal to the United States Court of Customs & Patent Appeals; (2) his Complaint must be filed within six months after the decision of the Patent Office; and (3) notice must be given to adverse parties *and other due proceedings had*. It is our view that these requirements are jurisdictional and the *complaint* by appropriate allegations *must show that the requirements are met; otherwise, the Court is without jurisdiction.* * * *."

The Court went on to say at page 380:

"In conclusion, it perhaps is not inappropriate to make a further observation. Our holding that the court was without jurisdiction because of plaintiff's failure to comply with Section 4915, *requires that the Complaint be dismissed*. If, however, it be held that plaintiff's failure to comply with this section merely goes to the power of the court to proceed, the same result would be reached for the reason that the six months' period provided by the section for bringing the action has expired and it is now too late for plaintiff to comply with such section". (Emphasis supplied).

In the present case the Complaint, "by appropriate allegations" does *not* "show that the requirements are met". On the contrary, the allegations of the Complaint, seeking remedies in addition to those provided by R. S. 4915, show that the requirements of 35 U. S. C. 72a are *not* met and that the Court had no jurisdiction.

In *Shell Development Company v. Universal Oil Products Co.*, 157 F. (2d) 421, the Third Circuit Court of Appeals affirmed the District Court's dismissal of a complaint under R. S. 4915 because the complaint did not name certain indispensable parties and because those parties did not make voluntary appearances until after six months from the

date of the decision of the Board of Interference Examiners. The Court said:

"For its second proposition appellant urges that it is not mandatory under R. S. Section 4915 for notice to or joinder of adverse parties within the statutory time for the filing of the bill in equity."

After discussing the *Klumb* case, *supra*, the Court said:

"* * *. What other due proceedings, if any, must be attended to within the six months, obviously depends on the circumstances of each case. It will be observed that though the time limitation was the important issue in the *Klumb* opinion and though it was insisted that the Court was clearly wrong in holding failure to comply with it, a *jurisdictional defect*—nevertheless certiorari was denied by the Supreme Court."

In the present case, the other due proceedings, if any, which should have been attended to within the six months, were the filing of a *proper* complaint, complying with the letter of 35 U. S. C. 72a, limiting the remedy sought to the specific remedy provided by R. S. 4915 (35 U. S. C. 63).

The Court in the *Shell* case relied upon *Nachod and U. S. Signal Co. et al v. Automatic Signal Corporation*, 105 F. (2d) 981 in which the dismissal of an action under R. S. 4915 had been affirmed because an indispensable or adverse party was not properly before the District Court for the District of Connecticut. There, the Circuit Court of Appeals for the Second Circuit pointed out that the plaintiff, although knowing that the defendant's exclusive licensee was not a resident of Connecticut, nevertheless had brought suit in that district. The Court said:

"* * *. Instead of doing this, if the plaintiff had chosen to avail itself of the privilege granted by Title 35 U. S. C. A. Sec. 72a, it could have sued in the District of Columbia and have obtained jurisdiction over both the inventor and licensee before the six months' statute of limitations created by Section 4915 had run.

But it neglected to take advantage of Title 35 U. S. C. A. Sec. 72a which was enacted in 1927 (Chapter 364, 44 Stat. 1934) to give relief in situations like the present and now finds itself without remedy under Section 4915."

In *Robinson v. Wayne*, 78 App. D. C. 15, 136 F. (2d) 767, this Court pointed out that the jurisdiction of our local District Court under 35 U. S. C. 72a must be determined from the allegations of the Complaint, and that jurisdiction could not be defeated by the failure of certain parties to respond to the summons. The Court said, referring to Section 72a:

"Obviously, the purpose of the statute is to make jurisdiction depend upon the situation which is revealed by the Complaint."

In the present case, the situation revealed by the Complaint demonstrates that the Court did not have jurisdiction, since *other relief* than an adjudication under R. S. 4915 was sought.

V.

Plaintiff contends (Br. 14) that, if it be decided that plaintiff is the prior inventor, "such a holding by its very nature constitutes a ruling on the validity of the patent involved" and argues that a determination of priority necessarily constitutes a determination of validity, so that the prayer for a judgment of invalidity and the prayer for a cancellation of the patent are not "other relief", prohibited by 72a.

However, as pointed out above (pp. 3, 4), plaintiff's "second cause of action" is entirely unrelated to the first. The first seeks an award of priority on the ground that plaintiff's prior Swedish application disclosed the invention in issue and that he is entitled to its date as a constructive reduction to practice. Under the first cause of action, plaintiff simply sought the grant of a patent on his inven-

tion. However, under the second cause of action, he seeks an adjudication of invalidity and a cancellation of defendant's patent, not on the basis of his own priority, but independently thereof, and *in spite of the insufficiency of disclosure of his own application*. The second cause of action is based *solely* on the ground that defendant allegedly failed to comply with the provisions of the Boykin Act, Public Law 690, 35 U. S. C. 101.

The Complaint demonstrates conclusively that the causes of action are unrelated and distinct and that the relief sought under the second is *in addition* to that sought by the first or sanctioned by R. S. 4915. The second cause of action (Paragraphs XVIII—XXI, Jt. App. 10A, 11A) contains not a single reference to the plaintiff's *application* for patent in the United States or his prior Swedish application, or to plaintiff's *invention*, or his claim to be the prior inventor; nor does it make any reference to the interference in the Patent Office between plaintiff and defendant, nor to the decision of the Board of Interference Examiners. It does not contain an allegation that a patent has been refused to plaintiff or that plaintiff is dissatisfied with any decision of the Board of Interference Examiners. Hence, it is *not* an action under R. S. 4915.

On the contrary, it is a bare-faced attack on the action of the Commissioner of Patents in granting a patent to defendant, and an attack on the validity of the patent.

VI.

Plaintiff's statement (Br. p. 15), "Thus, all of these facts alleged in the Complaint relate to the essential issue of an interference, namely, priority," is clearly erroneous and is not supported by the Complaint itself.

The authorities cited by plaintiff are not in point. *Robinson v. Wayne et al*, 78 App. D. C. 15, 136 F. (2d) 767 simply stands for the proposition that the purpose of 35 U. S. C. 72a was to make possible an adjudication of all issues of *priority*, as to all claims, between all adverse

parties, including those residing in different states and in foreign countries, in one proceeding and in one forum.

The phrase "without seeking other remedy" in Section 72a was *not* considered in *Autogiro Company of America v. Kay Gyroplanes Ltd.*, 55 F. Supp. 919. Defendant there did not move to dismiss on the ground that the complaint sought "other remedy". The motion to dismiss was based exclusively on the erroneous proposition that Section 72a did not apply to a *sole* defendant residing in a foreign country. The motion was overruled, and this Court denied a petition for special appeal. Whether or not the complaint was defective, as seeking other relief, was not considered or determined.

VII.

Plaintiff's brief (pages 22-24, Section VII) places great reliance upon this Court's decision in *Continental Distilling Corporation v. Old Charter Distillery Co. et al.*, 88 App. D. C. 188 F. (2d) 614 and states, "* * * The District Court would never have granted defendant's Hogdal's motion to dismiss, had the case been called to the Court's attention."

The *Continental* case involved entirely different facts and principles of law and is not an authority supporting plaintiff's contentions. The case did not involve an application for a patent or for a trade-mark registration, but, on the contrary, trade-mark *registrations* which had been granted to the opposing parties, one of which had been ordered cancelled by the Commissioner.

In order to understand the holding of the Court in the *Continental* case, it is necessary to review the decision of the Supreme Court in *United States ex rel. Baldwin Co. v. Robertson*, 265 U. S. 168, 68 L. Ed. 265, upon which it was based. In the *Baldwin* case, the plaintiff owned a trade-mark registration which had been ordered cancelled in a proceeding in the Patent Office. It brought an action in the Supreme Court of the District of Columbia for an injunction against the Commissioner, to prevent him from can-

celling the registration, contending that Section 9 of the Trade-Mark Act of 1905 (15 U. S. C. 89) gave the Court jurisdiction in an action under R. S. 4915 relating to patents, where it said:

“ * * * on complying with the conditions required in case of an appeal from the decision of the commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable”.

The Supreme Court reversed the decision of this Court dismissing the complaint saying:

“It is not an undue expansion of that construction to hold that the final words (of Section 9 of the Act of 1905) were intended to furnish a remedy in equity against the Commissioner in every case in which, by Section 9, an appeal first lies to the Court of Appeals. This necessarily would give to one defeated by the Commissioner as a party to an application for the cancellation of the registration of a trade-mark, after unsuccessful appeal to the advisory supervision of the Court of Appeals, a right to resort to an independent bill in equity against the Commissioner to prevent cancellation.

“ * * * . The applicants in Sec. 9 were of four kinds, and each of them were intended to be accorded the same resort to the Court of Appeals and the same remedy in equity as to the applicant for a patent in Sec. 4915. The inherent differences between trade-marks and patents should not prevent our giving effect to the remedial purpose of Congress in carrying out the analogies between the two classes of privileges to secure a common procedure.”

Thus, the Supreme Court held that one of the remedies provided by Section 9 of the Trade-Mark Act of 1905 was an action under R.S. 4915 by an unsuccessful trade-mark *registrant*, against the Commissioner of Patents to *enjoin* him from cancelling plaintiff's registration. This right of injunction against the Commissioner, therefore, is the *normal* remedy provided by R.S. 4915 in a *trade-mark* case,

and a complaint seeking such remedy is not "seeking other remedy", within the prohibition of Section 72a of Title 35 U.S.C.

This Court in the *Continental* case simply reached this conclusion, and decided nothing else. As in the *Baldwin* case, the plaintiff was an unsuccessful registrant in a cancellation proceeding, and its registration had been ordered cancelled by the Commissioner. The petitioner for cancellation was a resident of Delaware. Accordingly, the plaintiff invoked Section 72a against adverse parties residing in different states, Old Charter Distillery in Delaware and the Commissioner of Patents in the District of Columbia. This Court held:

" * * * It is, of course, beyond our province to say the Supreme Court erred in the *Baldwin* case, even if we thought it did. Not only are we bound by its ruling; we are also convinced the holding is correct.

* * * * *

" * * * . The complaint here did not 'seek other remedy' in our view. An injunction against the cancellation of the trade-mark was the *remedy properly sought under Sec. 4915 as construed by the Baldwin case*. The only other relief prayed for was that the Old Charter company be adjudged the owner of the mark. This was not the seeking of 'other remedy' but was an essential prerequisite to the right to an injunction. Obviously the District Court could not enjoin the Commissioner from cancelling the mark without first determining the appellee was the lawful owner of it. So we conclude no 'other remedy' was sought. Service of the writ in Delaware brought *Continental* before the District Court."

As indicated above, p. 10, in a case under R.S. 4915, growing out of a *patent interference*, however, an *injunction* against the Commissioner compelling cancellation of a patent and a judgment of patent invalidity are *not* "the remedy properly sought under Sec. R.S. 4915".

Thus, the Continental case holding that a prayer for an injunction to prevent cancellation of a trade-mark registration, did not seek other relief, is not authority for plaintiff's contention that a prayer for patent cancellation and invalidity does not seek other relief.

VIII.

Plaintiff's brief does not seriously contend that the trial court was in error in refusing him leave to amend the Complaint. On the contrary, plaintiff seeks a reversal of Judge Letts' dismissal of the Complaint as a whole, and a reinstatement in the District Court of *both* causes of action, so that plaintiff may attack the validity of defendant's patent, irrespective of the sufficiency of the disclosure of plaintiff's application and his right to an award of priority. The "second cause of action" seems to be the important one, and plaintiff's offer to delete it from the Complaint was a feeble one. On this appeal, the entire argument in support of the "right to amend" takes up less than one page of the brief, and no authority is cited, in the statutes, rules, or decisions.

Plaintiff took the same position in the Court below. No motion to amend was filed in the District Court, as required by Rules 7(b)(1)(2) and 15(a), F.R.C.P. No notice of such a motion was served, and points and authorities, as required by Local Civil Rule 9(b), were not filed. The latter rule specifies,

"With each motion, there shall be filed and served a separate paper stating the specific points of law and authorities to support the motion * * *. The moving party shall enter the motion and the fact of filing the statement on a card provided by the clerk."

Plaintiff's failure to move in the normal manner deprived defendant of his right to file opposing points and authorities and to request an oral hearing on the motion; rights secured by Local Rule 9(b).

Plaintiff's request to amend was not made until *after* the decision of Judge Letts, sustaining the motions to dismiss by *both* defendants, Hogdal and the Commissioner of Patents. The request was a mere "suggestion" made at the hearing on the form of the Final Judgment, when plaintiff informally offered, but did not file, an alternative form of judgment. The record shows (Jt. App. 32A) the following statement by plaintiff's counsel:

"I am suggesting that we be given leave to amend and delete the objectionable portions from the bill and from the prayers."

Plaintiff conceded (Jt. App. 33A) that an amendment "adding something to the Complaint" would have been beyond the District Court's authority, but contended, in spite of the Court's dismissal of the Complaint for failure to comply with the jurisdictional statute, the Court had jurisdiction, where the proposed amendment "only results in deleting something" (Jt. App. 34A). The basis for the Court's ruling is as follows:

"THE COURT: But I don't think I have the right to go beyond the terms of the statute. It seems to me that it is a jurisdictional question purely, and that jurisdiction arises out of the statute itself, where such statute must be strictly adhered to.

MR. HAYES: Yes, Your Honor, I agree that this complaint, since it did not comply with the statute, did not confer jurisdiction on this Court, and I think the Court has no authority to permit the amendment.

THE COURT: That is my conception of it, so I will accept the first order."

Defendant submits that the Court was correct in this conclusion and that there was no abuse of discretion in refusing to accept plaintiff's alternative final judgment, dismissing the Complaint as to the second cause of action only.

In *Radio Electronic Television Corporation v. Bartniew Distributing Corporation et al.*, 32 F. Supp. 431, 432, Judge

Clancy of the District Court for the Southern District of New York reached a similar conclusion, saying:

“We conclude, therefore, that any damage appearing from the complaint could be no more than nominal, and that the complaint must be dismissed for lack of jurisdiction. *Jessup v. Chicago & N. W. Ry. Co.*, C. C., 188 F. 931; *St. Paul Mercury Indemnity Co. v. Red Cab Co.*, 303 U. S. 283, 58 S. Ct. 586, 82 L. Ed. 845. *Being without jurisdiction, because of its deficiencies, we may not permit amendment.* 28 U.S.C.A. Sec. 80; *Betzoldt v. American Ins. Co.*, C. C., 47 F. 705; and *McEldowney v. Card*, C. C., 193 F. 475, are not contra. In both cases the Court had jurisdiction as a fact to its own knowledge and that of all parties. Rule 15 of the Federal Rules of Civil Procedure providing for one amendment of course is subject to the necessary constriction provided by Rule 82.”

In *United States v. Newbury Mfg. Co.*, 123 F. (2d) 453, 455, the plaintiff's complaints were dismissed for failure to state a claim upon which relief could be granted. On appeal, the First Circuit Court of Appeals was requested to vacate the judgments below and remand the cases so that plaintiff could amend. The Court held:

“ * * * . We are unable to find any such dispensing power in the Circuit Court of Appeals. See *Roemer v. Simon*, 1875, 91 U. S. 149, 23 L. Ed. 267; *Realty Acceptance Corp. v. Montgomery*, 1932, 284 U. S. 547, 52 S. Ct. 215, 76 L. Ed. 476; *Marden v. Campbell Printing-Press & Mfg. Co.*, 1 Cir., 1895, 67 F. 809. Even if we had such power, we should be disinclined to exercise it in the absence of a request by the District Court. And the case would have to be an extraordinary one indeed for us to exercise the power in the face of an express refusal of the court below, as here, to make the request. We perceive no such extraordinary circumstances in the cases now before us.”

In *Young v. Garrett et al.*, 5 F.R.D. 117, 121, the plaintiff did not seek to amend until after the judgments of dismissal had been affirmed by the Court of Appeals, whereas

here, the suggestion that an amendment be permitted was made after the decision of the District Court and before appeal. However, the language of the District Court is pertinent:

“ * * * . The plaintiffs were satisfied and insisted upon their original complaints and never indicated any desire to amend until the judgments of dismissal were affirmed on May 9, 1945. *Young v. Garrett, et al.*, supra. To permit an amendment now, it would be necessary for this court to modify the judgments appealed from and affirmed. This court does not have such power.”

In *C. E. Stevens Co. et al. v. Foster & Kleiser Co. et al.*, 109 F. (2d) 764, 769, the Circuit Court of Appeals for the Ninth Circuit affirmed the refusal of the District Court to amend, on the ground that the matter was within the discretion of the lower court, saying:

“ * * * . The matter of giving leave to amend is one in the sound discretion of the trial court. * * * . The reasons given by the trial court for denying leave to amend are persuasive here that there was no abuse of discretion. We place our decision sustaining the trial court in refusing leave to amend upon the ground that there was no abuse of discretion in such refusal and not upon the ground that appellants failed to request leave to amend after the court had announced that the demurrer to the complaint would be sustained without leave to amend.”

Defendant submits that the District Court did not abuse its discretion in refusing to permit an amendment to the Complaint, where the Court had no jurisdiction over the original complaint, because of its failure to satisfy the requirements of the special jurisdictional statute, 35 U. S. C. 72a. To permit an amendment would give the Court jurisdiction, retroactively, over a complaint as to which it had no statutory authority to consider, and would permit rectification of an inherently defective complaint, after the statutory period of limitations had run. It would be tan-

tamount to extending the six months' statute of limitations, expressly set forth in R. S. 4915, which expired on the very day the Complaint was filed, for an additional period of five months and eighteen days, when the suggestion to amend was made.

Having no jurisdiction under the statute over the Complaint as filed, the lower court was correct in refusing leave to amend.

CONCLUSION.

It is respectfully submitted that the judgment of the District Court dismissing the Complaint should be affirmed.

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